

This Opinion is Not a
Precedent of the TTAB

Mailed: March 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Sun Bum LLC

v.

Health Bomb LLC
—

Opposition No. 91264019
—

Karl T. Ondersma, Terence J. Linn, and Zakary S. McLennan of Gardner, Linn,
Burkhart & Ondersma for Sun Bum LLC.

Amanda Milgrom and Lindsey J. Brown of Milgrom & Daskam for Health Bomb
LLC.

—
Before Zervas, Wellington, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Health Bomb LLC (“Applicant”) seeks registration on the Principal Register of the
standard-character mark SKI BUM for “Face creams, non-medicated face serum” in
International Class 3.¹

¹ Application Serial No. 88802495 was filed on February 19, 2020 under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention
to use the mark in commerce in connection with the goods identified in the application.

Sun Bum LLC (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that SKI BUM so resembles Opposer’s registered and alleged common-law marks SUN BUM, BABY BUM, and TRUST THE BUM for various goods as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

The case is fully briefed.² We sustain the opposition.

I. Record

The parties “stipulate[d] to final disposition of this proceeding on the merits via Accelerated Case Resolution (‘ACR’) subject to the approval of the Trademark Trial and Appeal Board (‘Board’).” 11 TTABVUE 2. The parties’ ACR Stipulation set forth detailed provisions regarding the quantity and nature of evidence that each party could submit, and an agreed-upon trial schedule. *Id.* at 2-4. Following a conference with the parties to discuss the use of ACR, the Board approved the ACR Stipulation. 12 TTABVUE 1.³

² Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. The TTABVUE page numbers do not correspond to the numbered pages in briefs and other numbered docket entries. The parties designated portions of their briefs as “Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)” under the Board’s Standard Protective Order. Opposer’s redacted main brief appears at 34 TTABVUE and its redacted reply brief appears at 39 TTABVUE. Applicant’s redacted brief appears at 36 TTABVUE.

³ We commend the parties and their counsel for their cooperation in using ACR to resolve this case, which obviated the need to consider evidentiary issues, facilitated our review of an extensive record, and enabled the Board to focus on the merits of the case.

Pursuant to the parties' ACR Stipulation, the record consists of the pleadings,⁴ the Declaration of Dustin Smith, Opposer's International Account & Training Manager, and Exhibits A1-A39 thereto ("Smith Declaration" or "Smith Decl."), 13-15 TTABVUE;⁵ Opposer's Revised Submission of Exhibits B1-B19 pursuant to paragraph 4 of the ACR Stipulation, 25 TTABVUE 1-314;⁶ the Declaration of Ayssa DiPietro, Applicant's founder and owner, and Exhibits 1-19 thereto ("DiPietro Declaration" or "DiPietro Decl."), 22 TTABVUE 1-205;⁷ Applicant's Submission of Exhibits 1-67 pursuant to paragraph 4 of the ACR Stipulation, 20 TTABVUE 1-320;⁸ the cross-examination deposition of Mr. Smith and exhibits thereto, taken pursuant

⁴ Applicant denied the material allegations of Opposer's Notice of Opposition and did not interpose any cognizable affirmative defenses. 4 TTABVUE 2-4.

⁵ Opposer designated certain portions of the Smith Declaration as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the Smith Declaration and Exhibits at 13-15 TTABVUE. We will cite the Smith Declaration by paragraph and exhibit number (e.g., "Smith Decl. ¶ 6; Ex. A1") as well as by TTABVUE pages.

⁶ Paragraph 4 of the ACR Stipulation provides in pertinent part that "each party shall submit by filing with the TTAB any documents or discovery responses they wish to rely on during the Evidentiary Period, without the need for accompanying testimony." 11 TTABVUE 2-3. Opposer initially submitted Exhibits 1-67 at 17 TTABVUE 1-196, but later filed an uncontested motion to allow it to submit Revised Exhibits containing status copies of Opposer's registrations in Exhibits B1-B5 and B8-B14, and a statement pursuant to Trademark Rule 2.122(g). 24 TTABVUE 2. The Board granted the motion. 27 TTABVUE 1.

⁷ Applicant designated certain portions of the DiPietro Declaration as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the DiPietro Declaration and Exhibits at 22 TTABVUE. We will cite the DiPietro Declaration in the same manner as the Smith Declaration.

⁸ Applicant designated certain portions of its Notice of Reliance as "Confidential-Attorneys Eyes Only (Trade Secret/Commercially Sensitive)," and filed a redacted version of the Notice at 20 TTABVUE.

to paragraph 5 of the ACR Stipulation, 26 TTABVUE 1-117;⁹ and the parties' Stipulation of Facts ("Stipulation" or "Stip."). 30 TTABVUE 1-7.¹⁰

II. The Parties' Marks and Businesses¹¹

Opposer

Opposer has its headquarters in Encinitas, California and has a second facility in Cocoa Beach, Florida. Smith Decl. ¶ 1. Opposer produces and markets goods in five general categories described as "Sun," "Lifestyle," "Hair," "Baby," and "Lip." Smith Decl. ¶ 5 (13 TTABVUE 4).

The "Sun" category includes skin care products such as sunscreen lotions and sprays, aloe lotions and sprays, and browning lotions sold under the SUN BUM word and composite marks discussed below. Smith Decl. ¶ 5 (13 TTABVUE 4).¹² The "Lifestyle" category includes apparel, towels, toy figures, beach flyers, paddleball sets, footballs, water balls, and umbrellas sold under the SUN BUM word and composite marks. Smith Decl. ¶ 5 (13 TTABVUE 4). The "Hair" category includes shampoo, hair lighteners and toners, conditions, hair mists, sprays and detanglers,

⁹ We will cite the Smith cross-examination transcript by page and line numbers and by exhibit numbers (e.g., "Smith Tr. 16:14-20; Ex. 1") as well as by TTABVUE pages.

¹⁰ We will cite the Stipulation by paragraph number (e.g., "Stip. ¶ 2") as well as by TTABVUE pages. The Stipulation pertains to the parties' ownership of various registrations and applications for registration. The parties stipulated that all of their respective registrations are subsisting. Stip. ¶¶ 2-14.

¹¹ In this section, we set forth general findings regarding the parties and their marks and businesses. We make additional findings in Section IV below in connection with specific issues on Opposer's likelihood of confusion claim.

¹² Mr. Smith testified on cross-examination that this category also includes towelettes. Smith Tr. 26:11-14 (26 TTABVUE 28).

enhancers, oils, protectors, hair masks, and combs sold under the SUN BUM word and composite marks. Smith Decl. ¶ 5 (13 TTABVUE 4). The “Baby” category includes branded lotions, creams, shampoos and washers, hand sanitizer, sunscreens, detangler, balm, bubble bath, and bath and beach toys sold under the BABY BUM word and composite marks discussed below. Smith Decl. ¶ 5 (13 TTABVUE 4). The “Lip” category includes lip balm, sunscreen lip balm, and tinted lip balm products sold under the SUN BUM marks. Smith Decl. ¶ 5 (13 TTABVUE 4). Opposer has expanded its skin care product line from sunscreen and cool down lotions into additional lotions, as well as sunscreen moisturizers, and hydrating products. Smith Decl. ¶ 36 (13 TTABVUE 16); Smith Tr. 18:16-20 (26 TTABVUE 20).

Opposer owns the following registrations of the mark SUN BUM in standard characters:

- Registration No. 3572365 for “sunscreen cream” in Class 3;
- Registration No. 4289452 for “non-medicated sun care preparations” in Class 3;
- Registration No. 4870901 for “stickers” in Class 16, “headwear; T-shirts” in Class 25, and “toy animals” in Class 28;
- Registration No. 4012130 for “flying discs; footballs; paddle ball games” in Class 28; and
- Registration No. 5032467 for “hair care preparations; lip balm” in Class 3.

Stip. ¶¶ 3-7 (30 TTABVUE 2-3).

Opposer owns Registration No. 5863379 of the composite mark shown below:



for “Disposable wipes impregnated with cleansing chemicals or compounds for personal use; fragrances; non-medicated lip care preparations; lip balm; sun screen preparations; antiperspirants and deodorants for personal use; body sprays; body and beauty care cosmetics; cosmetic preparations, namely, firming creams and lotions; selftanning preparations; facial moisturizers; hair care preparations; suntanning preparations; liquid soap; bar soap; toothpaste” in Class 3; “stationery; notebooks; stickers; decals” in Class 16; “all-purpose carrying bags; travel bags; school bags; sport bags; wallets; umbrellas” in Class 18; “Pillows; accent pillows; plastic key chains; beach chairs; outdoor furniture; lounge chairs” in Class 20; “hair combs; hairbrushes; beverageware; coffee mugs; dinnerware; plates; cups; water bottles sold empty” in Class 21; “bath linen; towels; blanket throws; hooded towels; textile wall hangings; blankets for outdoor use; cushion covers” in Class 24; “clothing, namely, beachwear, beach cover ups, shirts; rash guards; sun protective clothing, namely, shirts; hats; wrist bands” in Class 25; and “toys, namely, action figures, water toys, inflatable toys, stuffed and plush toys; balls for sports; flying discs; paddle ball games” in Class 28. Stip. ¶ 8 (30 TTABVUE 3-4).

Opposer owns the following registrations of BABY BUM in standard characters:

- Registration No. 4321382 for “non-medicated sun care preparations” in Class 3;
- Registration No. 5555990 for “baby bubble bath; baby hand soap; baby lotion; baby shampoo; body cream; hair care preparations; lip balm; sunscreen cream” in Class 3; “towels” in Class 24; and “hats; T-shirts; underclothes; wraps” in Class 25; and
- Registration No. 5555991 for “plastic beach toy items, namely, sand toys, toy pails and toy shovels, and beach balls; toy animals” in Class 28.

Stip. ¶¶ 9-11 (30 TTABVue 4).

Opposer owns Registration No. 6205913 of the composite mark shown below:



for “baby bubble bath, hair care preparations for children, baby lotion, baby wipes, bath oil, sun screen preparations” in Class 3; “accent pillows, bedroom furniture” in Class 20; “drinking cups for babies and children, hair combs, hairbrushes” in Class 21; and “toys, namely, action figures, water toys, crib toys, bath toys, inflatable toys, stuffed toys; plastic beach toy items, namely sand toys, toy pails and toy shovels, and beach balls; balls for sports” in Class 28. Stip. ¶ 12 (30 TTABVue 4-5).

Opposer owns the following registrations of TRUST THE BUM in standard characters:

- Registration No. 3990792 for “Sunscreen cream” in Class 3; “stickers” in Class 16; and “T-shirts” in Class 25; and
- Registration No. 4129596 for “flying discs; footballs; paddle ball games” in Class 28.

Stip. ¶ 14 (30 TTABVue 5).

Opposer also owns pending applications to register (1) SUN BUM in standard characters for “Skin cream; Night cream; Eye cream; Face creams; Non-medicated skin serums; Beauty serums; Skin cleansers; Skin lotions; Moisturizing body lotions; Skin moisturizer; Skin masks; Non-medicated exfoliating preparations for skin; Facial washes; Skin toners; Skin clarifiers; Non-medicated face mists for skin care; non-medicated face mask for skin care; Mineral lotions for skin care; Non-medicated skin care preparations; Non-medicated skin brightening preparations, namely, exfoliating face wash, serum, cream, cleanser” in Class 3; “Reusable water bottles provided empty” in Class 21; and “Headbands” in Class 25; and (2) the SUN BUM composite mark shown above for “Skin cream; Night cream; Eye cream; Face creams; Nonmedicated skin serums; Beauty serums; Skin cleansers; Skin lotions; Moisturizing body lotions; Skin moisturizer; Skin masks; Non-medicated exfoliating preparations for skin; Facial washes; Skin toners; Skin clarifiers; Non-medicated face mists for skin care; nonmedicated face mask for skin care; Mineral lotions for skin care; Non-medicated skin care preparations; Non-medicated skin brightening preparations, namely, exfoliating face wash, serum, cream, cleanser” in Class 3; “Reusable water bottles provided empty” in Class 21; and “Headbands” in Class 25,

and (3). Stip. ¶¶ 15-17 (30 TTABVUE 5-6). These applications have filing dates that are later than the filing date of the opposed application.

Applicant

Applicant was founded in July 2017 by Ms. DiPietro, who resides in Miami, Florida. DiPietro Decl. ¶¶ 1-2, 63 (22 TTABVUE 3, 12). Ms. DiPietro founded Applicant in the course of transitioning from work in coastal engineering into the consumer-packaged goods space. DiPietro Decl. ¶ 7 (22 TTABVUE 4).

Applicant sells skincare products under what Ms. DiPietro called its “Miami Beach Bum brand,” which consists of products bearing either the MIAMI BEACH BUM mark or the SKI BUM mark. DiPietro Decl. ¶ 8 (22 TTABVUE 4). The MIAMI BEACH BUM product line was started in March 2018, DiPietro Decl. ¶ 9 (22 TTABVUE 4), and the MIAMI BEACH BUM mark was first used in April 2019. DiPietro Decl. ¶ 16 (22 TTABVUE 6). Applicant sells bum and body cream, face and body spritzer, leave-in conditioner, natural bug repellent, face cream, and various kits and apparel under the MIAMI BEACH BUM mark. DiPietro Decl. ¶ 35 (22 TTABVUE 8). Applicant owns Registration No. 6342955 of the mark MIAMI BEACH BUM in standard characters for “hair conditioners, face creams” in Class 3, and “clothing, namely, t-shirts, sweaters, hoodies, crop tops, rash guards, tank tops” in Class 25, Stip. ¶ 2, and Registration No. 5968556 of the mark MIAMI BEACH BUM in standard characters for “Body creams.” 20 TTABVUE 38-61. Opposer did not oppose registration of either MIAMI BEACH BUM mark. DiPietro Decl. ¶ 20 (22 TTABVUE 6).

Ms. DiPietro was the only person involved in the selection and adoption of Applicant's SKI BUM mark, 25 TTABVUE 293 (Applicant's Answer to Opposer's Interrogatory No. 7), and selected the mark in January 2019. DiPietro Decl. ¶ 24 (22 TTABVUE 7). As of the time of trial, Applicant was using the SKI BUM mark only in connection with a facial moisturizer product. DiPietro Decl. ¶¶ 27, 56, 73 (22 TTABVUE 7, 11, 14). Applicant does not currently sell any sunscreen or sun-protection products. DiPietro Decl. ¶ 60 (22 TTABVUE 12).

III. Statutory Entitlement to Oppose¹³

Applicant does not address Opposer's statutory entitlement to oppose, but "[a] plaintiff's entitlement to invoke a statutory cause of action for opposition or cancellation is a necessary element in every inter partes case even if, as here, the defendant does not contest the plaintiff's entitlement." *Sabhnani*, 2021 USPQ2d 1241, at *14-15 (citing *Chutter*, 2021 USPQ2d 1001, at *10) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021)). As the party in the position of plaintiff, Opposer may oppose Applicant's application if Opposer's claim is within the zone of interests protected by

¹³ "Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act under the rubric of 'standing.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *13 n.14 (TTAB 2021). "We now refer to what previously had been called standing as 'entitlement to a statutory cause of action.' But our prior decisions and those of the Federal Circuit interpreting 'standing' under §§ 13 and 14 remain applicable." *Id.* (quoting *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *10 n.39 (TTAB 2021)).

the statute, 15 U.S.C. § 1063, and Opposer has a reasonable belief in damage that is proximately caused by registration of Applicant's mark. *Sabhnani*, 2021 USPQ2d 1241, at *14.

Opposer has shown its entitlement to oppose registration of Applicant's mark based on the parties' stipulation to Opposer's ownership of subsisting registrations of various SUN BUM marks, which gives Opposer both an interest falling within the zone of interests protected by 15 U.S.C. § 1063, and a reasonable belief in damage that is proximately caused by registration of Applicant's mark. *Id.*

IV. Analysis of Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Opposer must prove both priority and likelihood of confusion by a preponderance of the evidence. *See, e.g., WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

A. Priority

Because the parties stipulated to Opposer's ownership of valid and subsisting Registrations Nos. 3572365, 4870901, 4289452, 4012130, 5032467, 5863379, 4321382, 5555990, 5555991, 6205913, 3990792, and 4129596, Stip. ¶¶ 4-14 (30 TTABVUE 3-5), and Applicant did not counterclaim to cancel any of them, "priority is not at issue

for the marks and the goods . . . identified in each individual registration.” *New Era*, 2020 USPQ2d 10596, at *9.

B. Likelihood of Confusion

Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter*, 2021 USPQ2d 1001, at *29 (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Opposer invokes nine of the 13 *DuPont* factors, 34 TTABVUE 14-36, while Applicant invokes a tenth and argues that five of the *DuPont* factors “weigh conclusively against a likelihood of confusion,” and the “other factors weigh either against a likelihood of confusion or are neutral.” 36 TTABVUE 12.

We will focus our *DuPont* analysis on the SUN BUM composite word-and-design mark shown in Registration No. 5863379 (the “379 Registration”) for, among other things, numerous Class 3 goods, including “body and beauty care cosmetics,” “cosmetic preparations, namely, firming creams and lotions,” and “facial moisturizers,” which the record shows is Opposer’s “main trademark.” *New Era*, 2020

USPQ2d 10596, at *11. “If we find a likelihood of confusion as to that mark and those goods, we need not find it as to Opposer’s other registered marks; conversely, if we do not find a likelihood of confusion” as to that mark and those goods, “we would not find it as to Opposer’s other registered marks for the goods identified therein.” *Id.*, at *9-10.

1. Similarity or Dissimilarity of the Goods, Channels of Trade, and Buyers to Whom Sales Are Made

“We begin with the second and third *DuPont* factors, which respectively consider ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’ and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhnani*, 2021 USPQ2d 1241, at *19 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567)). “We also discuss the portion of the fourth *DuPont* factor that addresses the ‘buyers to whom sales are made.’” *Id.* (quoting *DuPont*, 177 USPQ at 567).

“[W]e compare the goods as they are identified in the involved application and Opposer’s registration.” *New Era*, 2020 USPQ2d 10596, at *13 (citing *Stone Lion Capital Partners LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The goods identified in Applicant’s

application are “Face creams” and “non-medicated face serum.”¹⁴ As noted above, the goods identified in the ’379 Registration include “body and beauty care cosmetics” and “facial moisturizers.” The goods broadly identified as “body and beauty care cosmetics” in the ’379 Registration must be deemed to include all types of such “cosmetics.” *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). We take judicial notice that “cosmetics” are “substances that you put on your face or body that are intended to improve your appearance.”¹⁵ There is no doubt that the “body and beauty care cosmetics” identified in the ’379 Registration encompass the “face creams” and “non-medicated face serum” identified in the application. These goods are thus legally identical. *See, e.g., In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018); *Skincode GA v. Skin Concept AG*, 109 USPQ2d 1325, 1328 (TTAB 2013).

Moreover, as Opposer notes, 34 TTABVUE 27, Ms. DiPietro repeatedly referred in her testimony to the “face cream” that is sold by Applicant under the SKI BUM mark as a “facial moisturizer,” thus equating those goods identified in the application

¹⁴ Opposer need not show a likelihood of confusion as to both goods identified in the application, *Sabhnani*, 2021 USPQ2d 1241, at *19 n.17, but we find below that both goods are identical to at least one of the goods identified in the ’379 Registration.

¹⁵ CAMBRIDGE DICTIONARY (dictionary.cambridge.org, last accessed on March 7, 2022). “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format.” *Chutter*, 2021 USPQ2d 1001, at *36 n.72.

and in the '379 Registration, respectively.¹⁶ DiPietro Decl. ¶¶ 10 (Applicant's "SKI BUM facial moisturizer targets a damaged skin barrier and dry skin" and "[e]ach product in our skincare and body care collection, including the facial moisturizer sold under the SKI BUM mark, keeps the skin's natural biology top of mind as we formulate our products.") (22 TTABVUE 5); 56 ("The SKI BUM mark is currently used to market a facial moisturizer.") (22 TTABVUE 11); 57 ("SKI BUM facial moisturizer is a high-end beauty product.") (22 TTABVUE 11); 58 ("SKI BUM facial moisturizer is priced for sophisticated, discerning, high-end consumers and would not be considered an impulse buy.") (22 TTABVUE 11-12); 59 ("SKI BUM facial moisturizer is intended for use on the face only.") (22 TTABVUE 12); 61 ("SKI BUM facial moisturizer is sold online and in certain high-end boutique stores.") (22 TTABVUE 12); 62 ("SKI BUM facial moisturizer is sold nationwide online.") (22 TTABVUE 12); 67 ("SKI BUM is also sold under conditions in which the consumer is seeking a facial moisturized to prevent dry skin.") (22 TTABVUE 13). On the basis of Ms. DiPietro's testimony, we find that the goods identified in the application as "face creams" are equivalent to the goods identified in the '379 Registration as "facial moisturizers," and that those goods are legally identical.

Because both of the goods identified in Applicant's application are legally identical to at least one of the goods identified in the '379 Registration, "the second *DuPont*

¹⁶ Ms. DiPietro testified that as of the time of trial, "the SKI BUM mark is only used on one product: face cream." DiPietro Decl. ¶ 73 (22 TTABVUE 14).

factor strongly supports a finding of a likelihood of confusion.” *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *4 (TTAB 2020).¹⁷

With respect to the third *DuPont* factor regarding channels of trade, and the portion of the fourth *DuPont* factor pertaining to the buyers of the involved goods, Applicant again focuses on Opposer’s sun care products, arguing that

the class of purchasers are different based on the different purposes of the goods. Because sun protectant products are important for everyday outdoor activities, such goods are often purchased by the general public, and used by men, women, and children. However, face creams are typically purchased by individuals who are invested in skin care and who prioritize their skin health and appearance. Unlike sunscreen, face cream is not typically purchased by the general public or by people of all ages (and Applicant’s product is targeted to women of a ceratin [sic] age group.) Accordingly, the class of purchasers is different, weighing further against a likelihood of confusion.

36 TTABVUE 34.

Ms. DiPietro also testified that it was her “understanding that the products sold under the SKI BUM mark are sold in different trade channels than products sold under SUN BUM” and that “SKI BUM products are sold in high end retailers, while I believe that SUN BUM targets surfing and other outdoor retailers,” DiPietro Decl. ¶ 66 (22 TTABVUE 13), and that “SKI BUM facial moisturizer is priced for

¹⁷ Applicant’s arguments on the second *DuPont* factor are directed primarily to “Opposer’s core products and branding,” which Applicant argues “focus on sun protection for everyone.” 36 TTABVUE 33. To the extent that Applicant addresses the other cosmetics identified in the ’379 Registration, its argument implicitly concedes the similarity of the goods, as it argues that the mark shown in the ’379 Registration “is substantially different from Applicant’s Mark in appearance, sound, connotation, and commercial impression, such that, **regardless of any similarity of the goods**, there is no likelihood of confusion between these marks.” *Id.* at 34 (emphasis added).

sophisticated, discerning, high-end consumers and would not be considered an impulse buy” and “is not marketed towards families or children” but instead “is targeted at women, ages 25-45, as a skin rejuvenation tool, a way to repair the skin barrier and prevent dehydration from harsh, dry, and/or cold climates and environmental skin stressors.” DiPietro Decl. ¶ 58 (22 TTABVUE 11-12).

Applicant’s arguments and evidence directed to the actual channels of trade and classes of consumers for its and Opposer’s goods are unavailing. The identifications of goods in the application and in the ’379 Registration contain no restrictions or limitations as to channels of trade or classes of purchasers, and the legally identical goods in the application and in the ’379 Registration are thus “presumed to travel in the same channels of trade to the same classes of purchasers.” *Sabhnani*, 2021 USPQ2d 1241, at *20 (quoting *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *5 (TTAB 2019) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018)). “The third *DuPont* factor and the portion of the fourth *DuPont* factor regarding the buyers to whom sales are made thus also strongly support” a finding of a likelihood of confusion. *Id.*, at *21.

2. The Strength of Opposer’s Mark

The fifth *DuPont* factor is the “fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. Opposer argues that its SUN BUM mark is “famous and therefore entitled to a wide latitude of protection,” 34 TTABVUE 15, while Applicant argues that “Opposer has not provided sufficient evidence to show that the SUN BUM mark has achieved the level of recognition necessary for a mark to be considered famous.” 36 TTABVUE 35.

“In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength.” *New Era*, 2020 USPQ2d 10596, at *10 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006)).

a. Inherent or Conceptual Strength

The inherent or conceptual strength of the composite mark shown in the '379 Registration “is not seriously at issue. [The] mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.” *Id.* (citing *Tea Bd. of India*, 80 USPQ2d at 1899). The '379 Registration “is ‘prima facie evidence of the validity of the registered mark,” *id.* (quoting 15 U.S.C. § 1057(b)), and as we find below in our discussion of the first *DuPont* factor,¹⁸ there is “minimal evidence of registrations of

¹⁸ Applicant’s arguments regarding the conceptual weakness of Opposer’s marks appear in the portion of its brief devoted to the first *DuPont* factor regarding the similarity or dissimilarity of the marks, 36 TTABVue 13-17, in which Applicant argues that Opposer’s marks “are weak marks that should be afforded narrow protection.” *Id.* at 13. Applicant relies on third-party registrations of, and applications to register, marks containing the word BUM to show that the word BUM in Opposer’s mark is weak, *id.* at 13-14, and such evidence “goes only to the conceptual weakness of” Opposer’s mark. *Sabhnani*, 2021 USPQ2d 1241, at *24. We have considered Applicant’s arguments regarding the conceptual weakness of the word BUM in Opposer’s mark in our analysis below of the first *DuPont* factor. *See Guild Mortg.*, 2020 USPQ2d 10279, at *3 (finding that it was appropriate to consider the applicant’s evidence of the conceptual weakness of the cited mark under the first *DuPont* factor because “an analysis of the similarity between marks may include an analysis of the conceptual strength or weakness of the component terms and of the cited mark as a whole”) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)).

marks [containing BUM] for the same or similar goods that might demonstrate the inherent weakness of the [BUM] component as a source identifier.” *Id.* On the record here, we find that the mark shown in the ’379 Registration “is conceptually strong, and as discussed below, Applicant has not shown that the mark has been weakened.” *Id.*

b. Commercial Strength

“Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source.” *Id.* “Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown.” *Id.* (citing *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)). Because of “the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it.” *Id.* (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (internal citation omitted)).

Unlike fame for purposes of protection against dilution, which Opposer does not claim here, 39 TTABVue 10, “likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay*

Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). “[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.” *New Era*, 2020 USPQ2d 10596, at *11 (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734).

The commercial strength of a mark may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Id.*, at *10-11.

Opposer argues that its SUN BUM mark is famous based on the length and extent of sales bearing the marks, the extent of its advertising and promotional expenditures, media exposure of the goods, social media impressions, Opposer’s promotional events and sponsorships, product awards, and Opposer’s enforcement efforts, 34 TTABVue 15-23, concluding that “‘the fame of the [SUN BUM] mark plays a dominant role’ in this case.” *Id.* at 23 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).¹⁹ Opposer also cites a September 2020 “Brand Equity Tracking Study” (the

¹⁹ Opposer designated its sales and advertising figures, testimony regarding its social media and retail presence, and certain other testimony and exhibits in the Smith Declaration as “Confidential-Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive).” 34 TTABVue 16, 21 (citing Smith Decl. ¶¶ 8, 10-11, 13-15, 19-20, 23, 37 (13 TTABVue 5-9, 11-12, 17; 16 TTABVue 5-12, 17)). “[T]he Board must be able to discuss the record evidence in its opinions, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board’s decisions,” *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (quoting *Noble House Home Furnishings, LLC v.*

“Tracking Study”) as direct evidence that there is “no doubt that a significant portion of consumers across the United States are acutely aware and immediately recognize SUN BUM personal care products,” 34 TTABVUE 21-22 (citing Smith Decl. ¶ 33; Ex. A29 (13 TTABVUE 15; 15 TTABVUE 17; 16 TTABVUE 15, 199-207), while redacting the findings of the Tracking Study in both its brief and in the Smith Declaration on the ground that they are “Confidential-Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive).”²⁰

i. Sales and Advertising

Mr. Smith testified that Opposer’s “SUN BUM trademarked products have had significant growth and sales success.” Smith Decl. ¶ 8 (13 TTABVUE 5).²¹ Between 2010 and mid-2014, annual dollar sales of products in Opposer’s “Sun” and “Lip” categories increased from high five figures in 2010 to mid seven figures as of June 2014. Smith Decl. ¶ 8; Ex. A3 (16 TTABVUE 5, 21). Between 2014 and 2020, annual

Floorco Enters., LLC, 118 USPQ2d 1413, 1416 n.21 (TTAB 2006)), and we “may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.” Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g). We will honor the parties’ legitimate confidentiality designations consistent with our duty to explain the basis of our findings and ultimate decision by, for example, referring to evidence designated as confidential in general terms where possible or omitting information designated as confidential that is not germane to our analysis.

²⁰ Opposer discusses the Tracking Study in its fame argument in the unredacted versions of its main brief, 33 TTABVUE 21-22, and reply brief, 40 TTABVUE 11, Applicant discusses the Tracking Study in its argument against fame in the unredacted version of its brief, 37 TTABVUE 36-37, and we find that the Tracking Study is highly probative of the alleged fame of Opposer’s mark. Accordingly, we will discuss its methodology and contents in general terms to the extent necessary to explain our finding under the fifth *DuPont* factor.

²¹ Mr. Smith refers generally to the SUN BUM marks in his testimony, but the record shows that the composite mark shown in the ’379 Registration has consistently been used on Opposer’s products that do not bear its BABY BUM or TRUST THE BUM marks, and, as noted above, the record shows that the mark is Opposer’s primary mark.

dollar sales of products in Opposer's "Sun" category increased from mid seven figures in 2014 to very high eight figures in 2020, annual dollar sales of products in Opposer's "Hair" category increased from zero in 2014 to low eight figures in 2020, and annual dollar sales of products in Opposer's "Lip" category increased from very low seven figures in 2014 to very low eight figures in 2020. Smith Decl. ¶ 8; Ex. A4 (16 TTABVUE 5, 27). Total sales between 2010-2020 of products bearing Opposer's SUN BUM marks in its "Sun," "Hair," and "Lip" categories have been several hundred million dollars.²² Opposer currently sells its goods in the United States through more than 6,000 brick-and-mortar world retailers of various sorts, and has such retailers in all 50 states as well as in the District of Columbia and the Virgin Islands. Smith Decl. ¶¶ 11-12; Ex. A7 (16 TTABVUE 6-7, 30-32). Opposer also sells its goods through online platforms, including Amazon, Facebook, and Opposer's website at sunbum.com, as well as the online platforms of its retailers. Smith Decl. ¶ 13; Exs. A8-A-11 (13 TTABVUE 7, 398-450).

Opposer advertises and promotes its SUN BUM products in multiple manners, including on social media, its website, and YouTube, in print advertisements, through event and venue sponsorships, and through celebrity or athlete endorsements. Smith Decl. ¶ 18 (13 TTABVUE 9). Opposer's total estimated marketing expenditures, which cover numerous categories of expenses including merchandising cost/store displays, trade marketing, trade show expenses, promotional samples expenses,

²² Opposer also had sales revenues in the mid to high six figures over that period in its "Lifestyle" category.

advertising/media buys, ambassadors/influencers, sales materials/rep supplies, public relations expenses, agency fees, creative production, digital advertising, promotional events, and lifestyle and brand partnerships, have increased from very low seven figures in 2016 to very low eight figures in 2020, with total expenditures over that period in the low eight figures. Smith Decl. ¶ 19 (16 TTABVUE 9).

Applicant correctly notes that these figures do not compare favorably in absolute terms to the sales and advertising figures in cases in which the Federal Circuit has found marks to be famous under the fifth *DuPont* factor. 36 TTABVUE 35-36 (citing *Coach Servs.*, 101 USPQ2d at 1720 (finding fame of the opposer's COACH mark based in part on 2008 sales of roughly \$3.5 billion and advertising expenditures of about \$30-60 million); *Bridgestone Americas Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063-64 (Fed. Cir. 2012) (finding that the opposer's secondary marks were commercially strong based in part on "billions of dollars of sales")). See also *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (fame of OMAHA STEAKS mark supported by advertising expenditures of \$45 million in 2011 and over \$50 million in 2012 and 2013); *Bose*, 63 USPQ2d at 1306 (fame of ACOUSTIC WAVE mark supported by annual sales in excess of \$50 million and annual advertising expenditures of more than \$5 million over the 17 years of use of the mark prior to 2002); *Recot*, 54 USPQ2d at 1896 (fame of FRITO-LAY mark shown by expenditures in 1996 of about \$80 million and other evidence, including the facts that "[i]n any given year, over 90 percent of American households purchase at least one FRITO-

LAY brand product” and that “FRITO-LAY products enjoyed a greater than 50 percent market share in the estimated \$12.1 billion domestic snack chip industry.”); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) (fame of HUGGIES mark supported by sales in excess of \$300 million and advertising expenditures in excess of \$15 million in 1982 alone); *AutoZone Parts, Inc. v. Dent Zone Cos.*, 100 USPQ2d 1356, 1361-62 (TTAB 2011) (fame of AUTOZONE mark supported by advertising expenditures of over \$750 million during 23-year period of use, with the Board finding that although petitioner had “not placed its sales and advertising figures in context,” such context was “not necessary here in view of the volume of sales and advertising expenditures and the fact that petitioner’s advertising reaches over 90% of the U.S. population numerous times each year.”).

Because Opposer’s sales and advertising figures are not nearly of the magnitude of the figures in these cases, “some context in which to place [Opposer’s] raw statistics is reasonable,” *Bose*, 63 USPQ2d at 1309, but Mr. Smith did not testify as to how Opposer’s sales and advertising figures compare to those of its competitors. Instead, Opposer argues in its main brief that “[t]hese sales of tens of millions of SUN BUM branded products totaling hundreds of millions of dollars over many years, and the corresponding millions of dollars spent on marketing, thus establish the ‘fame’ of the SUN BUM mark in the context of the fifth *DuPont* factor,” 34 TTABVUE 17, and in its reply brief that it “is not required to show billions of dollars of sales and use of the mark for upwards of 50 years to establish the fame of its SUN BUM marks.” 39

TTABVUE 10. Opposer claims that its sales and advertising figures are comparable to those in one “Unpublished” Federal Circuit decision, *Money Station, Inc. v. Cash Station, Inc.*, 70 F.3d 1290, 38 USPQ2d 1150 (Fed. Cir. 1995) and in one Board decision, *Andrew Jurgens Co. v. Sween Corp.*, 229 USPQ2d 394 (TTAB 1986), if the sales and advertising figures in those two cases are expressed in current dollars after adjusting for inflation. *Id.* at 10-11.

The Federal Circuit has held that there are multiple ways in which to “contextual[ize] ad expenditures and sales figures,” *Omaha Steaks*, 128 USPQ2d at 1690, including “evidence of the type of advertisements and promotions [the plaintiff] uses to gain sales,” *id.*, and Opposer provides some such evidence, which we discuss below. In addition, there is direct evidence of the effectiveness of Opposer’s sales and advertising vis-à-vis its competitors in the form of the Tracking Study, which we also discuss below.

ii. Length of Use

Opposer argues that “[t]hrough its predecessor in interest, Agility Sports LLC, SUN BUM branded sunscreen was first used in early 2008.” 34 TTABVUE 16 (citing 25 TTABVUE 16 (Ex. B1)). Opposer cites a copy of its Registration No. 3572365 of the mark SUN BUM in standard characters for sunscreen cream, which recites a first use date of January 1, 2008, 25 TTABVUE 16, but the “allegation . . . in a registration, of a date of use is not evidence on behalf of the . . . registrant; a date of first use of a mark must be established by competent evidence,” Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), and Mr. Smith, who joined Opposer in September 2010, Smith Decl. ¶ 1 (13 TTABVUE 3), did not testify to any use of the mark before January 2010,

when Opposer used the SUN BUM trademarks in connection with goods in the “Sun,” “Lip,” and “Lifestyle” categories at a trade show. Smith Decl. ¶ 6; Ex. A1 (13 TTABVUE 4-5, 25-28). Applicant concedes the claimed earlier use in 2008, however, when it argues in its brief that “the SUN BUM mark has only been in use for about 14 years,” 36 TTABVUE 36, and the parties have thus agreed that the mark has been used since 2008.

Opposer’s 13 years of use of the SUN BUM mark at the time of trial is modest in comparison to the periods of use of marks in multiple cases in which the Federal Circuit and the Board have found marks to be famous under the fifth *DuPont* factor. *See, e.g., Bose*, 63 USPQ2d at 1306 (collecting cases); *New Era*, 2020 USPQ2d 10596, at *11 (use of the opposer’s NEW ERA mark since the 1930s and other evidence supported a finding that the mark was “on the much higher end of the commercial strength spectrum”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1821 (TTAB 2015) (use of the opposer’s BUDWEISER mark “since 1876, interrupted only by Prohibition,” supported a finding that the mark met “the applicable standard for fame”); *AutoZone Parts*, 100 USPQ2d at 1361-62 (23 years of use and other evidence supported a finding that the petitioner’s AUTOZONE marks was famous).

Each type of indirect evidence of fame cannot be considered in isolation, however, and a relatively short period of use may not be inconsistent with a finding of fame if the record contains sufficient other evidence to show that the mark has become famous during that period. *See, e.g., Rsch. in Motion Ltd. v. Defining Presence Mktg.*

Grp., Inc., 102 USPQ2d 1187, 1192-93 (TTAB 2012) (although the opposer's BLACKBERRY mark had been in use for only 13 years, the Board found that the mark was famous where the record showed billions of dollars in sales, tens of millions of dollars in advertising and promotional expenditures, intense media attention, the ranking of the mark as "among the most famous and valuable trademarks in the world by industry publications that track the powerful reach of global brands," and that by the mid-2000s, products bearing the mark "had become ubiquitous in the United States, and proved to be an important tool for business executives, government officials and many other professionals as a means for round-the-clock mobile communications."). The Tracking Study (discussed below) directly measures the fame of Opposer's mark resulting from its use for slightly more than a decade.

iii. Media Coverage

Opposer and its Sun Bum mark and products have received unsolicited exposure in the electronic and print media (including in online form). Smith Decl. ¶¶ 20-21; Exs. A15-A17 (13 TTABVUE 10-12; 14 TTABVUE 113-44, 146-83; 16 TTABVUE 159-82). In the electronic media, Opposer's sunscreen bearing the mark shown in the '379 Registration was featured on a November 13, 2020 episode of the Today Show in a segment devoted to the PEOPLE magazine Beauty Awards, which episode reportedly generated more than 3,000,000 media "impressions."²³ Smith Decl. ¶ 20; Ex. A15 (13 TTABVUE 10; 14 TTABVUE 115). The November 23, 2020 issue of PEOPLE

²³ Mr. Smith did not testify about how the numbers of media "impressions" were determined, but Applicant did not object to this evidence, so we will consider it for whatever probative value it has notwithstanding its hearsay nature.

containing the Beauty Awards and designating Opposer's sunscreen as "Best Face Sunscreen" reportedly generated more than 7,000,000 impressions. Smith Decl. ¶ 20; Ex. A15 (13 TTABVUE 10; 14 TTABVUE 116-17). Opposer's Sun Bum lip balm was featured on a July 12, 2019 segment of Good Morning America entitled "Summer Beauty Secrets," which reportedly generated more than 3,000,000 impressions. Smith Decl. ¶ 20; Ex. A16C (13 TTABVUE 11; 16 TTABVUE 169, 179).²⁴

Opposer's products have also been featured in magazines such as MEN'S HEALTH, COSMOPOLITAN, FITNESS, TOWN & COUNTRY, TEEN VOGUE, MARIE CLAIRE, MEN'S JOURNAL, BETTER HOMES & GARDENS, ESSENCE, STAR, WOMAN'S DAY, SHAPE, SNOW, and LIFE & STYLE, with each publication reportedly generating substantial numbers of impressions, Smith Decl. ¶ 20; Ex. A16 (13 TTABVUE 10-11; 14 TTABVUE 118-44), as well as on multiple websites, including those of THE WALL STREET JOURNAL, BUSINESS INSIDER, THE NEW YORK TIMES, USA TODAY, MEN'S JOURNAL, and THE HUFFINGTON POST. Smith Decl. ¶¶ 20-22; Exs. A17-A18 (13 TTABVUE 10-12; 14 TTABVUE 150, 155, 157, 164-66, 181-83).

iv. Product Awards

Mr. Smith testified that Opposer's "product packaging and store displays have been recognized in the industry." Smith Decl. ¶ 24; Exs. A20-A22 (13 TTABVUE 12; 14 TTABVUE 188-94). Opposer issued a press release in 2011 regarding its

²⁴ Opposer designated this exhibit, captioned 2019 "Summer Coverage Recap Press & Media Highlights," as "Confidential-Attorneys' Eyes Only (Trade Secret/Commercially Sensitive)," but it contains essentially the same information that Opposer made of record in the public files regarding the Today Show episode, so we have referred to it and summarized its information.

nomination for one of these awards, the Image Award of the Surf Industry Manufacturers Association (“SIMA”) for “Accessory Product of the Year,” Smith Decl. ¶ 24; Ex. A20 (13 TTABVUE 12; 14 TTABVUE 188-89), and Mr. Smith testified that Opposer “was again nominated for a SIMA award in 2012,” Smith Decl. ¶ 24 (13 TTABVUE 12), but there is no evidence that Opposer received either award and no evidence as to the extent of distribution of the 2011 press release. Opposer did receive two awards in 2020, the Silver Award in the National Association of Container Distributors (“NACD”) Packaging Awards Competition for the bottles for Opposer’s BABY BUM product line, Smith Decl. ¶ 24; Ex. A21 (13 TTABVUE 12; 14 TTABVUE 190-92), and the Bronze Award in the 2020 Outstanding Merchandising Achievement (“OMA”) “Shop Awards” for a Trust the Bum endcap display in the CVS chain that caused the product line to become number one in its category at CVS. Smith Decl. ¶ 24; Ex. A22 (13 TTABVUE 12-3; 14 TTABVUE 193-94).

Mr. Smith did not testify as to whether Opposer did anything to publicize its 2011 and 2012 nominations and its 2020 awards beyond the issuance of its 2011 press release, or as to the extent, if any, of the purchasing public’s awareness that Opposer received the nominations and awards. Without such context, his testimony about the nominations and awards establishes only that Opposer was viewed as a promising newcomer in 2011 and 2012 and as a successful marketer and packager by trade associations in 2020. This “only tend[s] to show that [Opposer’s] products are perceived to be of high quality or are recognized only by industry groups,” *Spier Wines*

(*Pty*) *Ltd. v. Shepherd*, 105 USPQ2d 1239, 1245 (TTAB 2012), not that its marks are famous.

v. Opposer's Enforcement Efforts

Opposer argues that it “zealously protects its SUN BUM mark against confusingly similar marks, including successfully opposing another SKI BUM mark abroad.” 34 TTABVUE 23 (citing Smith Decl. ¶ 35; Ex. A32 (15 TTABVUE 61-73)). The fame inquiry under the fifth *DuPont* factor, however, “is focused on whether the mark has achieved ‘extensive public recognition and renown,’ not on enforcement efforts.” *Omaha Steaks*, 128 USPQ2d at 1693 (finding that the Board’s error in refusing to take judicial notice of 20 lawsuits filed by the opposer was “thus harmless”) (quoting *Coach Servs.*, 101 USPQ2d at 1720)). Moreover, Opposer states that its enforcement efforts are “a result of the widespread consumer recognition of the SUN BUM marks,” 34 TTABVUE 23, not a cause.

vi. Opposer's Tracking Study

In most inter partes cases, the Board must assess the degree of fame of a plaintiff’s mark by synthesizing the sort of indirect evidence discussed above because “[d]irect evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion.” *New Era*, 2020 USPQ2d 10596, at *12 (quoting *Bose*, 63 USPQ2d at 1308). Here, however, Opposer introduced pages from the Tracking Study, which was conducted online in August 2020 by an independent brand research firm for purposes other than this litigation. Smith Decl. ¶ 33; Ex. A29 (16 TTABVUE 15, 199-207). The Board has previously considered such brand awareness studies as potentially probative evidence of fame, noting that the fact that such

studies are not conducted for purposes of litigation, but rather are “used in the ordinary course of business increases [their] probative value.” *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2022 (TTAB 2014) (characterizing multiple consumer recognition surveys commissioned by the opposer over a six-year period as “particularly persuasive” evidence of dilution fame of the CHANEL mark); *see also Nasdaq Stock Mkt., Inc. v. Antartica, S.r.l.*, 69 USPQ2d 1718, 1729 (TTAB 2003) (discussing annual surveys commissioned by the opposer to measure awareness of its stock market among the investing and general public); *Coach Servs.*, 101 USPQ2d at 1720 (substantial evidence supporting Board’s finding that the COACH mark was famous for purposes of likelihood of confusion included internal brand awareness study that “showed a high level of awareness of the COACH brand for women between the ages of 13-24”). The Board has characterized such brand awareness studies as direct evidence of consumer awareness of marks. *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1505 (TTAB 2005), *aff’d*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

The Tracking Study’s key objective was to determine “the awareness and brand health of the Sun Bum and Baby Bum brands to establish a baseline for the business moving forward” to assist Opposer in assessing “the impact of marketing activity on the health of the Sun Bum and Baby Bum brands and determine what actions should be taken in the future.” 16 TTABVUE 201.²⁵ The Tracking Study measured the

²⁵ The Tracking Study indicates that similar studies were conducted semi-annually in 2018 and 2019. 16 TTABVUE 203.

“unaided and aided awareness,” on the part of purchasers of sun care, hair care, lip care, and baby products within the previous six months, of what the Tracking Study called the “Sun Bum brand.” The terms “unaided awareness” and “aided awareness” are not defined in the pages from the Tracking Study in the record, but the Board has previously explained that “[u]naided’ awareness indicates that the survey participant spontaneously mentions the [relevant] brand name without prompting,” while “aided’ awareness means that the survey participant responds ‘yes’ when asked whether he or she is aware of the [relevant] brand name.” *Chanel*, 110 USPQ2d at 2022 n.10. *See also Carefirst*, 77 USPQ2d at 1507 (aided awareness is “awareness after the brand has been prompted.”); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1247 (TTAB 2015) (survey measured aided awareness by giving respondents a list of marks for frozen meals and asking them which products they had heard of previously); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1723 n.53 (TTAB 2007) (market research report “did not explain what was meant by ‘unaided awareness,’” but the Board’s review of the report itself indicated that “‘unaided awareness’ means awareness of the brand without prompting from the interviewer.”). Our review of the pages from the Tracking Study in the record indicates that the terms “aided awareness” and “unaided awareness” have the meanings discussed in these cases.²⁶

²⁶ The pages from the Tracking Study in the record frequently display the composite mark shown in the ’379 Registration, but by definition that mark would not have been exposed to respondents in the unaided awareness portion of the Tracking Study, where respondents were asked to name brands of which they are aware, and the Tracking Study does not suggest that the composite mark was the “prompt” for the respondents’ aided awareness. Accordingly, it appears that the Tracking Study measured awareness of the SUN BUM word mark rather

The Tracking Study reported that “[u]naided and aided brand awareness and the share of consumers who have ever tried the Sun Bum brand have risen significantly and are currently at an all time high among Core Sun Care Buyers,” 16 TTABVUE 203,²⁷ who were defined as “women aged 18-44 who purchased Sun Care products” in the previous six months. *Id.* at 202. The Tracking Study reported that as of the fall of 2020, the unaided awareness of the SUN BUM brand among “Core Sun Care Buyers” was slightly above single digits, while its aided awareness among that cohort was about five times that number. *Id.* at 203.

The Tracking Study compared the level of aided awareness of the SUN BUM brand to the level of aided awareness of two categories of competitive sun care brands: (1) a set of four “lesser-known brands,” and (2) the five “largest sun care players in the space.” *Id.* at 205.²⁸ The Tracking Study stated that “[a]lthough Sun Bum’s awareness has seen significant momentum and continues to rise, brand awareness is an opportunity area especially compared to the largest sun care players in the space.” *Id.*

than the composite mark per se. Because we find below in our analysis of the first *DuPont* factor that the words SUN BUM are the dominant portion of the composite mark, the focus of the Tracking Study on the SUN BUM word mark does not materially reduce its probative value on the question of the fame of the mark shown in the ’379 Registration.

²⁷ The levels of unaided awareness of the Sun Bum brand among sun care products buyers in 2018 and 2019 were all in the single digits, and the levels of aided awareness in 2018 and 2019 were all in the mid double digits.

²⁸ Unaided awareness figures for competitive brands were not reported. 16 TTABVUE 205.

The Tracking Study also compared the level of aided awareness of the Sun Bum brand among hair care product and lip care product buyers.²⁹ In the hair care category, the Sun Bum brand had an aided awareness in the mid double digits, which was “second lowest among hair care buyers.” *Id.* at 207. The five best-known hair care brands had much higher aided awareness. *Id.* In the lip care category, aided awareness of the Sun Bum brand was reported to be in the mid double digits, “slightly higher than that of hair care buyers, yet awareness still falls behind the other key lip care brands.” *Id.* at 208.

“In general, the Board has discouraged heavy reliance on aided awareness to prove fame.” *ProMark Brands*, 114 USPQ2d at 1247 (finding that 82% aided awareness of the opposer’s mark “lack[ed] significant evidentiary value on the question of fame” under the fifth *DuPont* factor). “[I]t is unaided awareness that is the most significant,” and “[o]ne should not be permitted to so heavily rely on aided awareness, that is, awareness after the brand has been prompted, to show fame.” *Carefirst*, 77 USPQ2d at 1507. The level of aided awareness of the Sun Bum brand among Opposer’s “Core Sun Care Buyers” reported in the Tracking Study is entitled to little weight in our analysis of fame under the fifth *DuPont* factor, particularly because it is considerably lower than the aided awareness levels of the brands of what the Tracking Study described as the five “largest sun care players in the space.” 16 TTABVue 205. Opposer’s aided awareness levels among hair care product and lip

²⁹ The Tracking Study did not report the level of unaided awareness of the Sun Bum brand among these cohorts.

care product buyers are similarly considerably lower than those of competitive brands in the same categories. Opposer's aided awareness level in all three categories "runs in the middle of the pack, significantly trailing several brands." *Carefirst*, 77 USPQ2d at 1506.

The level of unaided awareness of the Sun Bum brand among Opposer's "Core Sun Care Buyers" reported in the Tracking Study is quite modest. In *7-Eleven*, the opposer's market research study reported 73% unaided awareness of the opposer's BIG GULP mark for fountain soft drinks among all respondents and 78% unaided awareness among 7-Eleven customers. The Board found that the opposer's evidence of fame, "particularly the market research study," supported the conclusion that the BIG GULP mark "has a very high degree of public recognition and renown" under the fifth *DuPont* factor. *7-Eleven*, 83 USPQ2d at 1723. The study also reported unaided awareness figures of 16% for the opposer's SUPER BIG GULP mark among all respondents and 18% among 7-Eleven customers, and 2% overall for the opposer's DOUBLE GULP mark. *Id.* The Board concluded that "the evidence does not show any significant public recognition and renown for opposer's GULP trademark or for any other variance of the 'Gulp' trademarks."). *Id.* The level of unaided awareness of the Sun Bum brand is far below the 70%+ levels of unaided awareness found to support a showing of fame of the BIG GULP mark in *7-Eleven*, and is comparable to the levels of unaided awareness that were found not to support a finding of fame of the SUPER BIG GULP mark.

In *Carefirst*, the opposer's brand awareness studies, like the Tracking Study, reported significant gaps between the levels of unaided and aided awareness, with the unaided awareness levels in the single digits. The Board held that if "a mark were 'famous,' as contemplated under the law, among the class of relevant customers and potential customers, it would, in all likelihood, garner much higher numbers on unaided brand awareness than did opposer's mark that scored only in the single digits, even behind some of opposer's other brands." *Carefirst*, 77 USPQ2d at 1507. The unaided awareness level of the Sun Bum brand first emerged from the single digits in 2020, and the extremely-low double-digit level reported in the Tracking Study is not the sort of "much higher number" that the Board indicated in *Carefirst* was necessary to support a showing of fame.

The levels of unaided and aided awareness of the Sun Bum brand reflected in the Tracking Study do not support Opposer's claim that there is "no doubt that a significant portion of consumers across the United States are acutely aware and immediately recognize SUN BUM personal care products." 34 TTABVue 21-22.

vii. Conclusion Regarding Fame of Opposer's Mark

On the basis of the direct and indirect evidence of fame in the record, "[t]here is no question but that [O]pposer's mark has achieved a degree of recognition in the [sun care products] field. Fame is relative, however, not absolute, and the evidence, when considered as a whole, falls short of a convincing showing of fame." *Carefirst*, 77 USPQ2d at 1507. In view of the "underwhelming results of [Opposer's] brand awareness stud[y]," which is "the primary evidence of confirmatory context," *id.* at 1505, for Opposer's sales and advertising figures and other indirect evidence of fame,

we find “that the strength of the mark [SUN BUM] favors [O]pposer, but not to the extent that it would if the mark were famous, as fame has been contemplated in prior decisions of this Board and of the Federal Circuit.” *Carefirst*, 77 USPQ2d at 1507. Along the “spectrum from very strong to very weak,” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, we place the mark shown in the ’379 Registration on the “strong” side of the spectrum, but not “on the much higher end of the commercial strength spectrum.” *New Era*, 2020 USPQ2d 10596, at *12. The mark is entitled to something more than “the normal scope of protection to which inherently distinctive marks are entitled,” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017), and the fifth *DuPont* factor thus slightly supports a finding of a likelihood of confusion.

3. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani*, 2021 USPQ2d 1241, at *25 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1691). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (internal quotation omitted)).

“The proper test regarding similarity ‘is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.’” *Id.* (quoting *Cai*, 127 USPQ2d at 1801)

(internal quotation omitted). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customers here are purchasers of cosmetics, including face creams, non-medicated face serums, and facial moisturizers. “Because the identifications of goods in the [379 Registration and application] do not include any restrictions or limitations regarding channels of trade, classes of consumers, or prices, these purchasers . . . are ordinary consumers. *Id.*, at *27.

“Because the identified goods are identical in part, a lesser degree of similarity between the marks is required for confusion to be likely.” *Id.* (citing *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *New Era*, 2020 USPQ2d 10596, at *14).

Opposer focuses its argument in its main brief on “the two-word marks SUN BUM and SKI BUM,” which Opposer argues “have one identical term, and one highly similar term.” 34 TTABVUE 24. Opposer claims that these marks “are *identical* with respect to: (i) the suffix ‘BUM’; (ii) the number of words; (iii) the number of letters; (iv) the number of syllables; and (v) beginning and ending letters (‘S’ and ‘M’),” and that “both SUN BUM and SKI BUM evoke an outdoor connotation and meaning directed toward an individual engaged in an outdoor activity.” *Id.* (emphasis supplied by Opposer).

Applicant’s arguments against similarity begin with its claim that Opposer’s marks are weak marks that should be given narrow protection. 36 TTABVUE 13.

Applicant bases this argument on the claimed conceptual weakness of the word BUM in Opposer's marks, *id.* at 13-15, the fact that Opposer "allowed its products to be sold by an online retailer called 'The Ski Bum,' suggesting that Opposer was not concerned with customers confusing its products as originating from this online retailer" and that "[i]f Opposer believed that there was no likelihood of confusion with an online retailer selling Sun Bum's identical products under the name 'The Ski Bum,' then there certainly should be no likelihood of confusion with Applicant's mark for different, not identical goods," *id.* at 15-16, and the claim that Opposer's "marks as a whole are merely descriptive, or at best highly suggestive, of the listed goods, and are therefore weak on the spectrum of distinctiveness." *Id.* at 16. Applicant concludes this portion of its argument as follows:

Due to the large number of third-party BUM-based marks for identical or similar goods as Opposer's Marks, the descriptive nature of the other elements of Opposer's Marks, and the descriptive or highly suggestive nature of Opposer's Marks as a whole when applied to the same goods as Applicant's Mark, Opposer's Marks should be afforded narrow protection, and are therefore less likely to generate confusion over source.

Id. at 17.

Applicant then argues that the marks are dissimilar in appearance, sound, and meaning, *id.* at 17-29, and that "minute distinctions between the marks weighs [sic] against a likelihood of confusion." *Id.* at 18. With respect to appearance, Applicant argues that the "only similarity between the marks is the common element BUM, but this portion of the mark is weak and does not serve a source-identifying function due to common third-party use of this element, as discussed *supra.*" *Id.* According to

Applicant, “consumers would distinguish between SKI BUM and SUN BUM, which are for different goods, based on both the goods and the different first words of each mark – SKI and SUN.” *Id.* at 19. Applicant argues that “consumers are generally more inclined to focus on the first word of a trademark, such that consumers would be more likely to focus on the first words of Applicant’s Mark, SKI, and Opposer’s Marks, SUN, BABY, and TRUST.” *Id.* Applicant argues that “[b]ecause consumers are more likely to focus on the first words of the marks, and not the weak common element BUM, the first words of the marks are the dominant portions of the marks,” and “should be given greater weight, and due to their difference in appearance, sound, and connotation, weigh against a finding of a likelihood of confusion.” *Id.* at 20.

With respect to the mark shown in the ’379 Registration, Applicant argues that its mark is also distinguishable in appearance “based on the additional design features of the mark,” in which “the words SUN BUM appear in a stylized font above a cartoon figure of a gorilla wearing sunglasses.” 36 TTABVue 21. Applicant further argues that “[c]onsumers would be unlikely to confuse Applicant’s Mark SKI BUM with the stylized SUN BUM design, as the matching design elements (e.g., the matching U and U and the matching n and first arch of the m) link the words together in a manner that is not found in the combination of the elements SKI and BUM.” *Id.* Applicant argues that “the gorilla design is the dominant portion of the mark, which detracts from any similarity between the literal elements.” *Id.* Applicant cites several cases in which composite word-and-design marks such as the one shown in the ’379 Registration were found to be dominated by their design features. *Id.* at 21-22 (citing

In re Covalinski, 113 USPQ2d 1166 (TTAB 2014); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987); and *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966)). Applicant concludes that under these cases, the gorilla caricature in the mark shown in the '379 Registration "is a dominant/prominent design that is eye catching and engages the viewer before the viewer looks at the literal elements 'SUN BUM,' which are relatively smaller, rendering the gorilla design element the dominant portion of the mark and eliminating any likelihood of confusion with Applicant's Mark." *Id.* at 22-23.

With respect to sound, Applicant argues that "the first words of Applicant's Mark and Opposer's Marks are the dominant portions of the marks that consumers would focus on." *Id.* at 23. Applicant cites third-party registrations of SNOW BUMS and LAKE BUMS for clothing and concludes that "[i]f SNOW BUMS and SUN BUM for identical goods were all allowed to register and co-exist, then SKI BUM should also be allowed to register, as SKI sounds much more different from SUN than SNOW, and the mark is for different, not identical, goods." *Id.* at 24.

As to connotation and commercial impression, Applicant argues that the marks "also have markedly different, if not contrasting, meanings or connotations." *Id.* According to Applicant, "[n]ot only are the dominant portions of the marks, SKI and SUN, completely different, but they also connote opposing imagery," namely, "cold versus hot, snow versus sand, mountains versus beach, and winter versus summer."

Id. at 25. Applicant further argues that “SKI BUM is a well-known word phrase, that as a whole, has a distinctive meaning, rendering the Mark a unitary mark,” *id.* at 26, which “conveys images of a person who lives paycheck to paycheck at or near a ski resort in the mountains and spends most of their time skiing,” *id.*, while SUN BUM “merely describes an intended user of the identified goods, and as such, is merely descriptive of the goods.” *Id.* at 28. Applicant concludes that “[c]onsumers would be unlikely to confuse SKI BUM, a strong mark with an arbitrary meaning in connection with the goods (highend face cream), with SUN BUM, a weak mark that immediately describes a user of the goods (a person in the sun) and feature of the products (e.g., sun protection).” *Id.*

With respect to the mark shown in the '379 Registration, Applicant also argues that

[m]onkeys and gorillas are often found in tropical places, where beachgoers often travel and sunscreen is important to protect from the sun. Further, the connotation of someone out in the sun is further apparent with this mark due to the additional design element of a gorilla wearing sunglasses. Sunglasses, like sunscreen, are helpful to protect from the sun. Thus, the additional design elements of a monkey wearing sunglasses further distinguishes the mark from SKI BUM.

Id.

Applicant also claims that “there are numerous marks that coexist that incorporate the element BUM and evoke an outdoor connotation, including, for example, MIAMI BEACH BUM, AUSSIE BEACH BUM, BEACH BUM GANG, BEACH TOWN BUMS, BOAT BUMS, LAKE BUM, and SNOW BUMS,” *id.* at 29, and that “[d]espite these marks all having an outdoor connotation, these marks are

distinguishable based on the different non-BUM portions of the marks and the differences in the specific outdoor connotations invoked by each mark.” *Id.*

Applicant’s final argument for dissimilarity is that “[a]ny similarity between the marks is mitigated by the vast differences in the respective packaging of the goods.” *Id.* at 30. Applicant argues that the parties “use additional elements on their packaging to set them apart, including their respective brand labels,” and “[a]ny likelihood of confusion is therefore mitigated by these vast differences in the packaging and branding of the products bearing these marks.” *Id.* at 31. We have given this argument no further consideration because “we cannot consider the use of the parties’ marks on their actual packaging in assessing the similarity of the marks.” *Sabhnani*, 2021 USPQ2d 1241, at *30 n.23.³⁰

We begin by addressing Applicant’s arguments and evidence regarding third-party marks because they form the basis for many of Applicant’s arguments regarding the dissimilarity of the involved marks, including its argument that “[w]hen comparing a mark to a weak mark, minute distinctions between the marks weighs [sic] against a likelihood of confusion.” 36 TTABVue 18. “Evidence of the

³⁰ Applicant primarily relies on *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 75 USPQ2d 1098 (2d Cir. 2005), as support for this argument. That case, and the others cited by Applicant, were civil infringement suits in which courts necessarily “look[ed] to the overall impression created by the logos and the context in which they are found and consider[ed] the totality of factors that could cause confusion among prospective purchasers.” *Star Indus.*, 75 USPQ2d at 1105 (quoting *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 26 USPQ2d 1583, 1587 (2d Cir. 1993)). Under the first *DuPont* factor, by contrast, “we do not consider how Applicant and [Opposer] actually use their marks in the marketplace, but rather how they appear in the registration and application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1185 (TTAB 2018).

extensive registration and use of a term by others can be powerful evidence of the term's weakness.” *Sabhnani*, 2021 USPQ2d 1241, at *21 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd*, 125 USPQ2d 1043, 1057 (TTAB 2017)). “The purpose of introducing evidence of third-party use is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Id.*, at *22 (quoting *Omaha Steaks*, 128 USPQ2d at 1693 (internal quotations omitted)). “Third-party use may bear on the commercial weakness of a mark,” *id.* (citing *Tao Licensing*, 125 USPQ2d at 1057), “and may be ‘relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” *Id.* (quoting *Omaha Steaks*, 128 USPQ2d at 1693 (internal quotations omitted)). “Third-party registrations ‘may bear on conceptual weakness if a term is commonly registered for similar goods or services.’” *Id.* (quoting *Tao Licensing*, 125 USPQ2d at 1057).³¹

³¹ Evidence of use “is the only evidence relevant to the commercial weakness of [Opposer’s] mark,” *Sabhnani*, 2021 USPQ2d 1241, at *23 (citing *Tao Licensing*, 125 USPQ2d at 1059 (“[a]s to *commercial* weakness, ‘[t]he probative value of third-party trademarks depends entirely on their usage’”) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693)), and where, as here, the involved goods are identical, third-party uses on other goods or services have “no real probative value for the analysis at hand.” *Omaha Steaks*, 128 USPQ2d at 1695. Mr. Smith was cross-examined about his knowledge of the use of various third-party BUM-formative marks, Smith Tr. 59:12-63:8 (26 TTABVUE 61-65), but he was aware only of the mark LUCKY BUM for toys and sleds, Smith Tr. 59:12-14 (26 TTABVUE 61), which is irrelevant to our analysis. The only other third-party use of a BUM-formative mark in the record is the use of the mark and trade name “The Ski Bum” by the Delaware retailer mentioned by Applicant that sells goods through its website at theskibum.com. Smith Decl. ¶ 13; Ex. A11 (13 TTABVUE 7, 425-27). According to the retailer’s website, it has been in business since 1974, and sells a variety of goods in addition to Opposer’s sun care products, including “ski and snowboard equipment footwear, outdoor clothing and outdoor accessories . . . and more.” Smith Decl. ¶ 13; Ex. A11 (13 TTABVUE 426). There is no evidence that the retailer sells any goods under its house mark “The Ski Bum,” and no evidence that any third party uses a

Applicant's main argument is that "there are numerous other trademark registrations and allowed trademark applications for similar goods as Opposer's Marks which contain the element BUM . . . rendering this portion of the mark weak as a source-identifier for similar goods," 36 TTABVUE 13, and that "evidence of numerous third-party registrations that incorporate BUM for similar or identical goods establishes the BUM portion of Opposer's Marks 'has a normally understood and well-recognized descriptive or suggestive meaning' in connection with the goods and is a weak portion of the marks." *Id.* at 14-15.

Opposer acknowledges that "Applicant has submitted copies of 41 various trademark registrations and applications with marks containing the term 'bum,'" 34 TTABVUE 31 (citing 20 TTABVUE 4-13),³² but argues that "[t]his evidence provides no support for the sixth *DuPont* factor favoring Applicant" because "although third-party use of a similar mark is a relevant consideration, third-party registrations are not evidence of use or consumer awareness of such marks." *Id.* (emphasis supplied by Applicant) (citations omitted). Opposer also notes that "[o]f the 44 registrations and applications Applicant has submitted as evidence, 14 have been cancelled or abandoned for failure to file a statement of use or acceptable declaration under

BUM-formative mark in connection with the "body and beauty care cosmetics" and "facial moisturizer" identified in the '379 Registration, or the "face creams" and "non-medicated face serum" identified in the application.

³² The cited pages at 20 TTABVUE contain a table summarizing Applicant's two registrations of MIAMI BEACH BUM and the opposed application to register SKI BUM, which do not involve third-party marks for purposes of showing the conceptual weakness of the word BUM in Opposer's marks, as well as third-party registrations and applications. The third-party registrations and applications themselves appear at 20 TTABVUE 80-250.

Section 8, and thus, have no probative value.” *Id.* at 32. Opposer further argues that 24 of the marks “do not list goods in Class 003, much less goods even tenuously related to personal care products of the sort at issue here,” leaving “five marks, two of which are MIAMI BEACH BUM marks owned by Applicant,” *id.*, and that these marks have little or no probative value because of their nature. *Id.* at 33.

We agree with Opposer that Applicant’s evidence of third-party BUM-formative marks does not establish the conceptual weakness of the word BUM in the mark shown in the ’379 Registration. Applicant submitted USPTO electronic records regarding 11 third-party applications, 20 TTABVUE 80-87, 92-95, 104-07, 112-18, 158-72, 177-83, 194-201, seven of which had been abandoned by the time Applicant submitted them. *Id.* at 80-87, 112-19, 158-72. Applications “are evidence only that they were filed,” *Bond v. Taylor*, 119 USPQ2d 1049, 1054 n.11 (TTAB 2016) (citing *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007)), and “are not evidence of use of the marks.” *Inn at St. John’s*, 126 USPQ2d at 1745. Applicant’s application evidence has no probative value in showing the conceptual weakness of the word BUM in Opposer’s mark.

Applicant also submitted 30 third-party registrations. 20 TTABVUE 88-92, 96-103, 108-11, 119-57, 173-76, 183-93, 202-50. They cover a wide variety of goods, but only four, for the marks BONDI BUM, BRAZILIAN BUM BUM, CHEEKY BUM, and HONEY BUM, cover goods in Class 3. *Id.* at 108-11, 120-24, 128-31, 140-42.³³ The 26

³³ Opposer argues in its reply brief that the registrations of CHEEKY BUM and HONEY BUM have been cancelled, 39 TTABVUE 7 n.1, but cites no supporting record evidence. “The Board does not take judicial notice of registrations in Office records,” *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *1 n.5 (TTAB 2020) (citation omitted), and in the

registrations covering other goods and services “have little or no probative value in showing the conceptual weakness of the word [BUM] in [Opposer’s] mark.” *Sabhnani*, 2021 USPQ2d 1241, at *24 (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration)).

While the four marks covering goods in Class 3 “all contain the word [BUM], they contain additional elements that cause [each] of them to be less similar” to the words SUN BUM in Opposer’s mark shown in the ’379 Registration than Applicant’s SKI BUM mark is to those words. *Id.*, at *25. Applicant’s evidence of four third-party registrations “of varying probative value,” *id.* (quoting *Inn at St. John’s*, 126 USPQ2d at 1745-46), “is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in both *Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015). *Id.*, at *25-26 (quoting *Inn at St. John’s*, 126 USPQ2d 1745-46).³⁴ We find that Applicant did not show that the

absence of contrary record evidence, we will treat those registrations as subsisting at the time of trial.

³⁴ “[I]n *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record . . . and in *Jack Wolfskin*, there were at least fourteen . . .” *Sabhnani*, 2021 USPQ2d 1241, at *26 n.20 (quoting *In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1746 n.8 (TTAB 2016)).

word BUM in Opposer's mark in the '379 Registration is conceptually weak, or that the mark, in its entirety, is entitled to a narrow scope of protection.³⁵

We turn next to Applicant's argument that the design element of the mark shown in the '379 Registration is its dominant portion. "While marks must be considered in their entireties, 'in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.'" *Id.*, at *30-31 (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

"In marks 'consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.'" *Id.*, at *31 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). "The verbal portion of a word and design mark

³⁵ As noted above, Applicant argues that "the other elements of Opposer's Marks are weak as they are also merely descriptive of the goods," 36 TTABVue 16, noting that "the other element, SUN, of the SUN BUM marks in Class 003, the same class as Applicant's mark, is disclaimed as it is merely descriptive of the associated goods." *Id.* Applicant concludes that Opposer's "marks as a whole are merely descriptive, or at best highly suggestive, of the listed goods, and are therefore weak on the spectrum of distinctiveness." *Id.* The '379 Registration issued without a showing of acquired distinctiveness, and we must thus presume that the registered mark is, at worst, suggestive of the goods for which it is registered. Applicant's several arguments that the mark shown in the '379 Registration is "merely descriptive" or "descriptive," 36 TTABVue 13, 16-17, 25, 28, "are inappropriate in the absence of a counterclaim to cancel" the '379 Registration. *Anheuser-Busch*, 115 USPQ2d at 1824 n.10.

‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184).

Consistent with the general principle discussed in these cases, the words Sun Bum appear alone in text in media coverage of Opposer and its products. Smith Decl. ¶ 20; Exs. A15-A16 (13 TTABVUE 10; 14 TTABVUE 113-32). Examples are shown below:



14 TTABVUE 114.

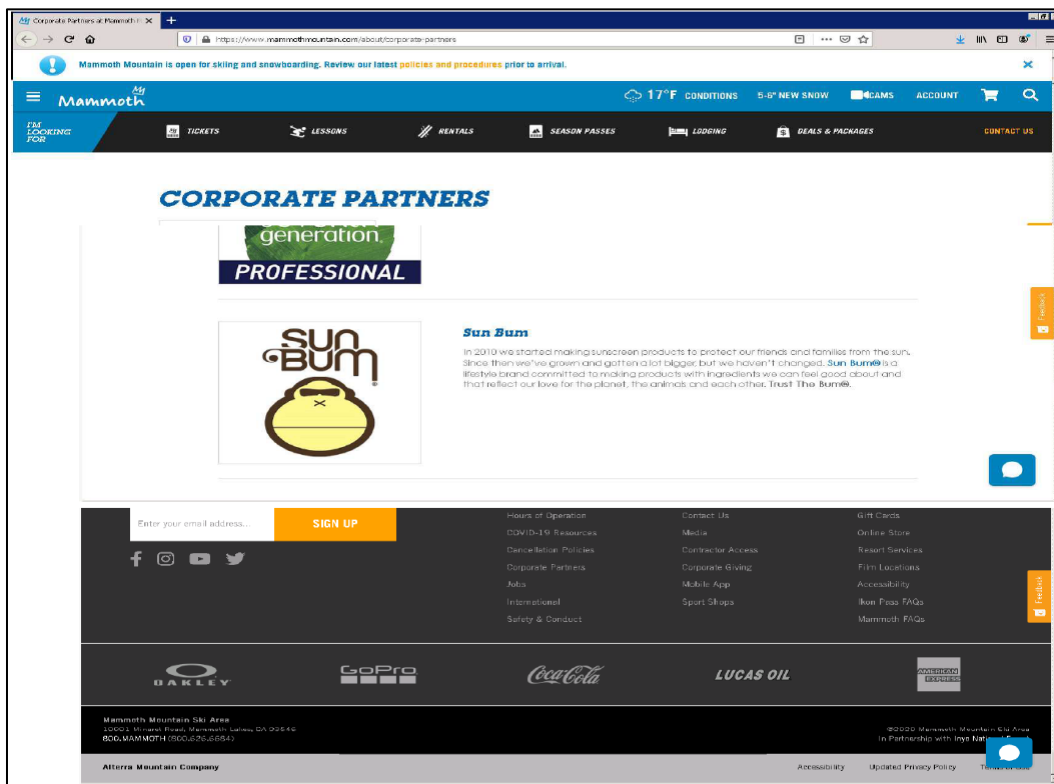


Id. at 122.



Id. at 129.

The same is true in references to Opposer's sponsorships, as exemplified below:

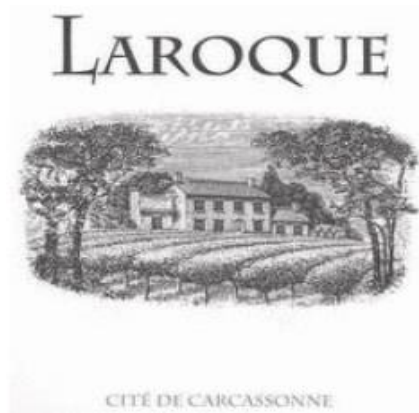


Smith Decl. ¶ 29; Ex. A27 (13 TTABVUE 14; 15 TTABVUE 8).

The mark shown in the '379 Registration, reproduced again below for ease of reference in following our discussion,



shares some of the key characteristics of the applicant's mark in *Aquitaine Wine USA*, shown below



which the Board found to be dominated by the word LAROQUE. *Aquitaine Wine USA*, 126 USPQ2d at 1185. The words SUN BUM appear above the gorilla caricature “in large, bold typeface,” *id.* at 1184, and they are “also the first [element] in the mark, further establishing [their] prominence.” *Id.* at 1184-85 (citing *Palm Bay Imps.*, 73 USPQ2d at 1692; *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)). “[B]ecause of the positioning, size and bolding” of the words SUN BUM, *Aquitaine Wine USA*, 126 USPQ2d at 1185, they are the part of the mark that is most

“likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Sabhnani*, 2021 USPQ2d 1241, at *31 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184).

As discussed above, Applicant cites the *Covalinski*, *White Rock Distilleries*, *Parfums de Coeur*, *Steve’s Ice Cream*, and *Ferro* cases in support of its claims that the gorilla caricature is the dominant portion of the mark shown in the ’379 Registration, and that the marks are distinguishable in appearance because of the presence of that design element in Opposer’s mark. It is axiomatic that “[e]ach case must be decided on its own facts, and the differences are often subtle ones.” *Chutter*, 2021 USPQ2d 1001, at *29 (quoting *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973)). The cases cited by Applicant are distinguishable in any event based on differences between the records and the composite marks in those cases and the record and the composite mark here.

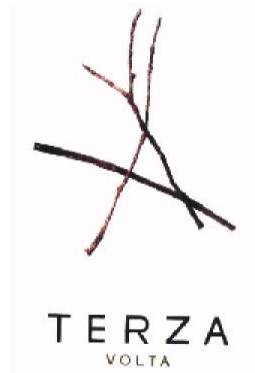
The applicant’s composite mark in the *Steve’s Ice Cream* case shown below is the one that is closest in nature to the mark shown in the ’379 Registration:



In *Steve's Ice Cream*, the Board did not expressly identify the dominant portion of the applicant's mark, but instead found no likelihood of confusion between the applicant's composite mark for "restaurant services" and the opposer's standard-character mark STEVE'S for "ice cream for consumption on and off the premises." In making that determination, the Board noted that the record showed that more than 200 restaurants and food stores operated in the United States under a STEVE'S-formative mark, *id.*, which the Board found "demonstrate[d] that the purchasing public has become conditioned to recognize that many businesses in the restaurant and food store fields use the term, or something closely related to it, and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks." *Steve's Ice Cream*, 3 USPQ2d at 1479.

Here, as noted above, there is no evidence that Opposer's mark is commercially or conceptually weak in the manner of the first name "Steve's" in *Steve's Ice Cream*, and the record shows that Opposer's Sun Bum brand has achieved some commercial strength. Moreover, while we agree with Applicant that the gorilla caricature is "eye catching," 36 TTABVUE 22, it is not so prominent in size or nature vis-à-vis the word SUN BUM, unlike the "highly stylized depiction of humanized frankfurters, prancing arm in arm to musical notes" at issue in *Steve's Ice Cream*, 3 USPQ2d at 1479, to make the gorilla design the part of the mark shown in the '379 Registration that is more likely to be recalled and used to identify and refer to the goods sold under that mark.

In *White Rock Distilleries*, the Board considered the likelihood of confusion between the registered composite mark shown below for “sparkling fruit wine; sparkling grape wine; sparkling wine; wines”



and the applicant’s standard-character mark VOLTA for “energy vodka infused with caffeine.” The Board found that “the prominent design feature and the term TERZA in the registered mark serve to distinguish the registered mark visually from applicant’s mark” because “the term TERZA clearly dominates over the term VOLTA in the registered mark as TERZA appears in large bold letters above VOLTA.” *White Rock Distilleries*, 92 USPQ2d at 1284. The Board also noted that the words in the registered mark “appear[ed] in a plain block style of lettering under the more prominent design.” *Id.*

Here, as discussed above, the words SUN BUM appear in bold stylized lettering above the gorilla caricature as the first portion of the mark, and they are far more prominent vis-à-vis the gorilla design than was the word Volta vis-à-vis the design in the composite mark in *White Rock Distilleries*.

In *Covalinski*, the Board considered the likelihood of confusion between the applicant’s composite mark shown below for various types of clothing



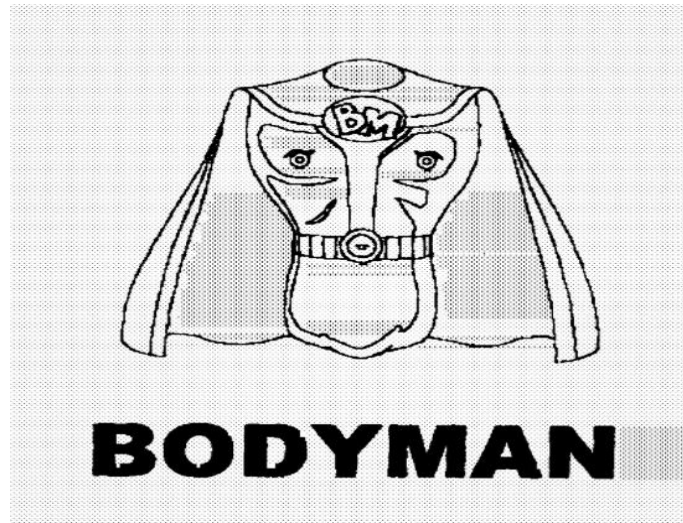
and the cited standard-character mark RACEGIRL for the same goods. The Board found that “the overall commercial impression of Applicant’s mark is dominated by its design features, particularly the large double-letter RR configuration, and that this weighs heavily against a conclusion that confusion is likely.” *Covalinski*, 113 USPQ2d at 1169. The Board based its finding on the following characteristics of the applicant’s mark:

Applicant’s design mark includes the very large, prominently displayed letters RR. The bodies of the Rs are filled with a checkerboard pattern resembling a racing flag. To each R an elongated horizontal ‘leg’ of gradually increasing thickness is appended, each of which ends in a heart design. Inside the legs appear the rest of the letters (i.e., the letter strings ‘edneck’ and ‘acegirl’), in a form in which the initial letters of each string are displayed in relatively tiny typeface and subsequent letters are displayed in increasing thickness. Together, these graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice.

Id. at 1168.

The mark shown in Opposer’s ’379 Registration shares none of the key characteristics of the applicant’s mark in *Covalinski*. To the contrary, the words SUN BUM are set apart from the gorilla caricature design and are plainly visible, and they are not subordinate to, much less obscured by, that design.

In *Parfums de Coeur*, the Board found that the composite mark shown below



for “entertainment services in the nature of an animated television series” was not confusingly similar to the mark BOD MAN for fragrances, in part because of its finding that the word BODYMAN was not the dominant portion of the applicant’s mark. *Parfums de Coeur*, 83 USPQ2d at 1016. The Board found, as it did with respect to the mark in *White Rock Distilleries*, that “the design is prominently displayed, being the largest element of the mark, and at the top of the mark.” *Id.* The Board also noted that the design was “reminiscent of a super hero costume,” and that the mark was “intended to be used for an animated television series,” a “visual medium.” Finally, the Board noted the significant differences between men’s fragrances and an animated television series. *Id.* at 1017.

The goods here are identical and, as noted above, the words SUN BUM appear above the gorilla caricature as the first portion of the mark, and the gorilla design is not nearly as large relative to the words SUN BUM as the super hero costume was relative to the word BODYMAN in *Parfums de Coeur*.

Finally, in *Ferro*, the Court of Customs and Patent Appeals affirmed the Board's dismissal of an opposition to registration of the composite mark shown below for rust preventative oils



based on various registered FERRO-formative word and composite marks for similar goods.³⁶ The court agreed with the applicant's argument that "the term 'gard' and the design dominate the mark sought to be registered and thus the likelihood of confusion is not present" because of "the presence of the animated bolt carrying a flag on which are the letters 'VCI'" and the fact that "the word 'gard' is in larger and bolder lower case letters than the term 'Ferro' which is in smaller letters and above the term 'gard.'" *Ferro*, 148 USPQ at 915.

Here, as discussed above, the two words SUN and BUM are of roughly equal size to one another and appear together above the gorilla caricature, which in turn is of roughly equal size to the words. *Ferro* does not support Applicant's claim that the gorilla design alone dominates the mark shown in the '379 Registration.

Having found that the words SUN BUM are the dominant portion of the mark shown in the '379 Registration, we turn to the required comparison of the marks in

³⁶ The opposer's two registered composite marks are not shown in the reported decision from 1966.

their entireties, giving greater weight in that comparison to the words SUN BUM in the mark shown in the '379 Registration than to gorilla design element.

With respect to appearance, Applicant's SKI BUM mark is a standard character mark that "could be used in any typeface, color, or size, including the same stylization actually used . . . by [Opposer], or one that minimizes the differences or emphasizes the similarities between the marks." *Anheuser-Busch*, 115 USPQ2d at 1823. "[W]e must consider that the literal elements of the [SKI BUM] mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color of the literal portions of" the mark shown in the '379 Registration. *Aquitaine Wine USA*, 126 USPQ2d at 1186. "This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color." *Id.* (citing *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)). Accordingly, in assessing the visual similarity of the marks, we must assume that the words SKI and BUM in Applicant's mark could appear in the same font and stacked presentation as the words SUN and BUM in the mark shown in the '379 Registration, "such that the words [SKI] and BUM look very similar to one another, linking the words together in the design." 36 TTABVUE 21.

Applicant's mark SKI BUM, and the dominant portion of the mark shown in the '379 Registration, the words SUN BUM, both consist of two three-letter words, the first of which begins with S- and the second of which is the identical word BUM.³⁷

³⁷ We reject Applicant's argument that "[b]ecause consumers are more likely to focus on the first words of the marks, and not the weak common element BUM, the first words of the

“[M]arks ‘must be considered . . . in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). Applicant’s SKI BUM mark, depicted in the stacked presentation and font of the words SUN BUM in Opposer’s mark shown in the ’379 Registration, would appear to be similar to Opposer’s mark when encountered separately by a consumer who has a general rather than specific impression and recollection of Opposer’s mark. We find that the marks are more similar than dissimilar in appearance when considered in their entirety.

With respect to sound, the mark shown in the ’379 Registration is likely to be verbalized as “SUN BUM” because the gorilla caricature is “likely to be ‘viewed, not spoken.’” *Sabhnani*, 2021 USPQ2d 1241, at *36 (quoting *In re Electrolyte Labs., Inc.*,

marks are the dominant portions of the marks.” 36 TTABVUE 20. We have found above that the word BUM is not a weak element of the mark shown in the ’379 Registration, and we find below that both Opposer and Applicant have built their product line extensions on the word BUM. To the extent that there is a dominant word in the SUN BUM portion of the mark shown in the ’379 Registration, it is BUM because SUN modifies, and reinforces and directs emphasis to, BUM, and has been disclaimed as descriptive of the goods identified in the ’379 Registration. *See Sabhnani*, 2021 USPQ2d 1241, at *37 (holding that the “structure of the verbal portion of Petitioner’s mark (‘ROYAL MIRAGE’) counsels against a reflexive application of the principle cited by Respondent that ‘consumers are generally more inclined to focus on the first word, prefix o[r] syllable in any trademark or service mark’,” because ROYAL “modifies and is subordinate to the noun MIRAGE” and has been found to be highly suggestive) (internal citations omitted). *See also United Trademark Holdings, Inc. v. Disney Enters., Inc.*, ___ F.4th ___, 2022 BL 61721, at *6 (Fed. Cir. Feb. 24, 2022) (finding that the “lead-word TEEN” in the applicant’s standard-character mark TEEN TINKER BELL for dolls was a “descriptive or suggestive adjective that merely qualifies and characterizes the rest of” the applicant’s mark, and “reinforces and directs emphasis to the rest of the mark.”). In Applicant’s mark SKI BUM, the word SKI similarly modifies and “reinforces and directs emphasis to” BUM.

913 F.2d 930, 16 USPQ2d 1238, 1240 (Fed. Cir. 1990)). Just as marks are not compared in appearance by viewing them side by side, they are not compared in sound by pronouncing them sequentially. We must consider the general impression of the sound of the words “Sun Bum” when the mark shown in the ’379 Registration is verbalized that is likely to be recalled by a consumer who subsequently hears the “Ski Bum” mark verbalized. Such a consumer may notice the differences between “Sun” and “Ski,” but is more likely to notice the identical sound of the second word “Bum.” The marks are more similar than dissimilar in sound because, when verbalized, they are both short phrases that end with the identical word BUM.

With respect to meaning, Applicant argues that “SKI BUM is a well-known word phrase, that as a whole, has a distinctive meaning” that “conveys images of a person who lives paycheck to paycheck at or near a ski resort in the mountains and spends most of their time skiing,” 36 TTABVue 26, while SUN BUM “merely describes an intended user of the identified goods, and as such, is merely descriptive of the goods.” *Id.* at 28. We agree with Applicant that the words SUN and SKI in the marks suggest warmth and cold, respectively (to the extent that SKI refers to snow skiing rather than water skiing), but as explained above, we may give greater weight to certain portions of the marks when considering the similarity or dissimilarity of the meaning of the marks as a whole. At the core of both marks is the “bum” who indulges himself or herself, in one case in the sun, and in the other with skiing.

Opposer has used the word BUM as the fulcrum of the extensions of its branding from SUN BUM into BABY BUM and TRUST THE BUM. Smith Decl. ¶¶ 7, 25

(discussing the “Bum Rush Tour” that promotes the goods at surprise surfing contests), 34. Applicant has similarly used the word BUM to extend its branding from its first product sold under the MIAM BEACH BUM mark, “our signature Bum + Body Cream in Mint and Orange,” DiPietro Decl. ¶ 16 (22 TTABVUE 6), into its SKI BUM product. DiPietro Decl. ¶¶ 8-10, 15-16, 30, 32 (22 TTABVUE 4-7). According to Applicant, MIAMI BEACH BUM and SKI BUM “are a family of related marks covering similar goods and services owned by [Applicant],” DiPietro Decl. ¶ 32 (22 TTABVUE 7). Mr. Smith similarly testified on cross-examination that he considers the SUN BUM and TRUST THE BUM marks to be part of a group or family of marks. Smith Tr. 57:11-21 (26 TTABVUE 59). The parties’ self-styled families of marks have the identical “surname,” “Bum.”

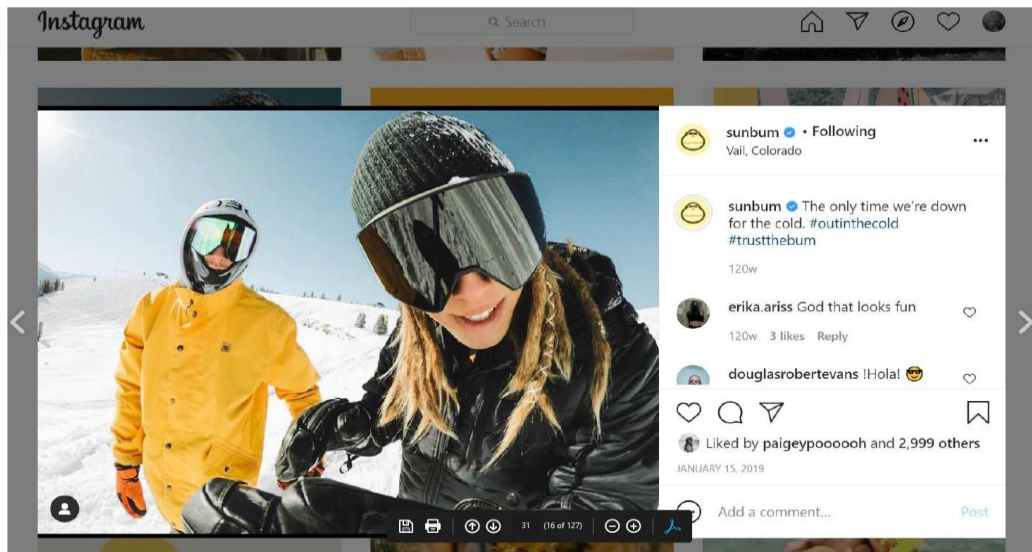
“Under the circumstances, and in the absence of any evidence to the contrary, we find that it is appropriate to give relatively less weight to the adjective[s] [SUN and SKI] than to the noun [BUM] in determining the connotation and commercial impression of [the] mark[s].” *Sabhnani*, 2021 USPQ2d 1241, at *38 (citing *Stone Lion*, 110 USPQ2d at 1161) (holding that the Board did not err in “according little weight to the adjective ‘STONE’ in applicant’s STONE LION CAPITAL mark” in the course of “finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning and overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”).

We disagree with Applicant that the marks “are distinguishable based on the different non-BUM portions of the mark and the differences in the specific outdoor connotations invoked by each mark.” 36 TTABVUE 29 (emphasis supplied by

Applicant). Applicant admits that part of Opposer's "targeted consumers" for the goods identified in the '379 Registration are skiers, 36 TTABVUE 27-28, and Opposer has promoted those goods through promotional events related to snow skiing, sponsorships of skiing venues, and participation in trade shows directed to skiers. Smith Decl. ¶¶ 28-32, 38, 41; Exs. A26-A28, A36, A40 (13 TTABVUE 13-15, 17-18, 15 TTABVUE 4- 18, 82-87, 125-27). An example of one such promotion is depicted below:

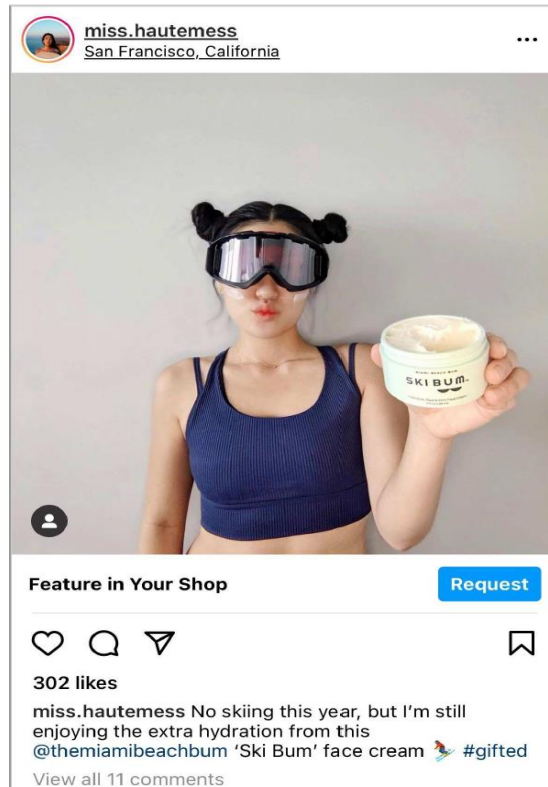


Smith Decl. ¶ 30; Ex. A40 (13 TTABVUE 14; 15 TTABVUE 127). Opposer has also promoted its goods through social media posts directed to winter sports enthusiasts:



Smith Decl. ¶ 31; Ex. A28 (13 TTABVUE 15; 15 TTABVUE 16).

The record shows that the classes of consumers for the goods identified in the '379 Registration and in the application include skiers and that the channels of trade for the identified goods include retail outlets catering to skiers. Opposer's goods have been distributed through retailers such as Alpin Haus, Confluence Kayak & Ski, Donor Ski Haus, Homewood Mountain Resort, Johnny's Ski and Board House, Mt. Hood Ski Bowl, Pyramid Ski and Snowboard Rentals, Ski Haus, Ski Hoodoo, and Skiology Ski and Sports. Smith Decl. ¶ 42; Ex. A39 (13 TTABVUE 18; 15 TTABVUE 94-97, 102-04, 107-09, 111-12, 117, 121-24). Applicant has also promoted its SKI BUM products to skiers through what Ms. DiPietro described as "influencers":



DiPietro Decl. ¶ 36; Ex. 6 (22 TTABVUE 8, 43).



DiPietro Decl. ¶ 36; Ex. 6 (22 TTABVUE 8, 46). Ms. DiPietro also stated in a video accessible on Applicant's website at miamibeachbum.com/products/ski-bum that "Ski Bum was inspired by my active lifestyle and minimalist routine. Whether I'm coming out of the ocean from kayaking or off the slopes from skiing this is my go to face cream for replenishing my skin." 17 TTABVUE 158 (Applicant's Response to Opposer's Request for Admission No. 3).

Against this backdrop, we find that the differences in meaning between the mark SKI BUM and the words SUN BUM, the dominant portion of the mark shown in the '379 Registration, resulting from the references to skiing and sunning oneself, are outweighed by the similarities arising from their common connotation of an outdoor enthusiast who focuses on recreation. Consumers familiar with the SUN BUM mark shown in the '379 Registration, and Opposer's BABY BUM and TRUST THE BUM line extensions, who separately encounter Applicant's SKI BUM mark for legally identical goods, could readily understand SKI BUM to be the next variant of Opposer's SUN BUM mark reflecting the extension of Opposer's line into products directed to consumers who ski in the winter and engage in other outdoor activities, including those, like Ms. DiPietro herself, who "spend a lot of time at the beach" and "also ski a lot." DiPietro Decl. ¶ 63 (22 TTABVUE 12).³⁸

³⁸ Mr. Smith testified on cross-examination that Opposer considered a line extension at some point under the SNOW BUM mark, which he explained "show[ed] the versatility and the ability of Sun Bum to chameleon into other categories." Smith Tr. 41:2-3 (26 TTABVUE 43). He authenticated a Snow Bum logo, mockups of Snow Bum products, and a mockup Instagram screen shot from a Snow Bum account, all of which exhibits were produced by Opposer in discovery. Smith Tr. 40:6-43:18; Exs. 4.1-4.5 (26 TTABVUE 42-45, 110-14).

We find that the SUN BUM composite mark shown in the '379 Registration and Applicant's standard character SKI BUM mark are much more similar than dissimilar in all means of comparison when they are considered in their entireties. The first *DuPont* factor thus supports a finding of a likelihood of confusion.

4. Purchase Conditions and Consumer Sophistication

“As noted above, the fourth *DuPont* factor examines both ‘the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *Sabhnani*, 2021 USPQ2d 1241, at * 39 (quoting *DuPont*, 177 USPQ at 567). “Purchaser sophistication may tend to minimize the likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Id.*, at *39-40 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1695 (citing *Recot*, 54 USPQ2d at 1899)). “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *Id.*, at *40 (quoting *Recot*, 54 USPQ2d at 1889).

Applicant argues that “[t]he use of the marks in the marketplace is relevant in the likelihood of confusion analysis,” 36 TTABVUE 31, and that “Applicant’s goods are high-end products that retail for \$48 for a 3oz. jar, . . . are sustainably manufactured, environmentally friendly, and use non-harmful ingredients, . . . and are targeted to women ages 25-45 who shop at boutique stores.” *Id.* According to Applicant, “[s]uch consumers are selective, taking time to review labels and verify ingredients, and are less likely to make an impulse purchase due to the high price.” *Id.* at 31-32.

Applicant contrasts its actual goods with those of Opposer, which Applicant argues “are inexpensive (e.g., sunscreen retails from \$9.99 for an 8 oz. bottle) . . . and are sold in nationwide big-box chain stores, such as Target and Walmart.” *Id.* at 32. Applicant also claims that “[i]t does not appear that Opposer has the same values as Applicant, and many of its products contain various chemicals and harmful ingredients.” *Id.* According to Applicant, “Opposer’s goods are targeted towards people of all ages, including families and children, with the goods commonly sold in family-sized packaging (e.g., 8oz. containers vs. Applicant’s 3oz. jars)” and “[s]uch consumers are often budget-conscious and would likely pay attention to product cost and/or packaging (e.g., for family-sized products). By paying close attention with purchasing decisions, consumers would be unlikely to confuse the marks.” *Id.*³⁹

Applicant concludes that its actual goods “are akin to luxury goods, while Opposer’s goods are akin to necessity goods,” and that “Applicant’s prospective sophisticated consumers are unlikely to confuse Opposer’s necessity goods that include harmful ingredients with Applicant’s environmentally-friendly, luxury

³⁹ Applicant cites no authority or evidence supporting its novel argument that consumers of what Applicant calls “luxury” goods and consumers of what it calls “necessity” goods will **both** exercise significant care in purchasing the goods due to their respective high and low prices, and “[a]ttorney argument is no substitute for evidence.” *Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). Applicant’s argument that purchasers of low-priced goods who “pay attention to product cost and/or packaging (e.g., for family-sized products),” 36 TTABVue 32, are unlikely to be confused as to source is both illogical and contrary to longstanding Federal Circuit precedent. By definition, such consumers care only about price (value), not source, and “[w]hen products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” *FabFitFun*, 127 USPQ2d at 1673 (finding that the unrestricted “cosmetics at issue include lower cost make-up items that may be purchased without a high degree of care.”) (quoting *Recot*, 54 USPQ2d at 1899)).

goods,” while “Opposer’s prospective budget-conscious consumers are unlikely to mistake Applicant’s expensive face cream for Opposer’s cheaper family-friendly products.” *Id.*⁴⁰

“Our decision under the fourth *DuPont* factor ‘must be based on the identification of goods in the [’379] Registration and [the application], as that determines the scope of the benefit of registration.’” *Sabhnani*, 2021 USPQ2d 1241, at *41-42 (quoting *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *7 (TTAB 2020) (citing *Stone Lion*, 110 USPQ2d at 1162)). The goods broadly identified in the application as “face creams” and “non-medicated face serum” are not restricted to “facial moisturizer [that] is priced for sophisticated, discerning, high-end consumers,” DiPietro Decl. ¶ 57 (22 TTABVue 11), and we must deem them to “include all goods of the type identified, without limitation as to their nature and price.” *Sabhnani*, 2021 USPQ2d 1241, at *42 (quoting *Sock It to Me*, 2020 USPQ2d 10611, at *7). Accordingly, we must assume that the “face creams” and “non-medicated face serum” identified in the application cover both expensive and inexpensive goods. *See id.* (goods identified broadly as “perfumes” must be treated “as including inexpensive as well as high-end perfumes,” and the Board must “presume that purchasers for these goods include ordinary consumers who may buy inexpensive perfume on impulse.”) (quoting *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123

⁴⁰ The relevant issue, of course, is “not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods.” *In re Embiid*, 2021 USPQ2d 577, at *28 n.39 (TTAB 2021) (quoting *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)).

USPQ2d 1744 (Fed. Cir. 2017)). *See also Stone Lion*, 110 USPQ2d at 1163 (“Board precedent requires the decision to be based on ‘the least sophisticated potential purchasers.’”) (quoting *Gen. Mills., Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)).

The least sophisticated consumers of the identified goods would exercise no more than ordinary care, and we find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

5. Absence of Evidence of Actual Confusion

The eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Guild Mortg.*, 2020 USPQ2d 10279, at *6 (quoting *DuPont*, 177 USPQ at 567). “The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [Applicant] of its mark for a significant period of time in the same markets as those served by [Opposer] under [its] mark[].” *Sabhnani*, 2021 USPQ2d 1241, at *47 (quoting *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (quoting *Gillette Can. Inc. v. Ranir Corp.*, 1768, 1774 (TTAB 1992)). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Id.* (quoting *Citigroup*, 94 USPQ2d at 1660).

“As noted above, our analysis of the second, third, and fourth *du Pont* factors, discussing the similarity or dissimilarity of the [goods], channels of trade, and

relevant consumers, is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the [application and '379 Registration].” *Id.* (quoting *Guild Mortg.*, 2020 USPQ2d 10279, at *6 (emphasis in *Guild Mortg.*)). The eighth *DuPont* “factor, by contrast . . . requires us to look at **actual market conditions**, to the extent there is evidence of such conditions in the record.” *Id.*, at *48 (quoting *Guild Mortg.*, 2020 USPQ2d 10279, at *6 (emphasis in *Guild Mortg.*)). “Accordingly, we must look to the parties’ actual activities in the marketplace to determine whether there has been a reasonable opportunity for confusion to have occurred.” *Id.* (quoting *Citigroup*, 94 USPQ2d at 1660).

Ms. DiPietro testified that “[t]o the best of [her] knowledge and belief, there has been no consumer confusion to date relating to the origin of SKI BUM products,” that she has “never had any potential or current consumer or retailer raise any concerns about the origin of SKI BUM products, or any concerns that SKI BUM belongs to the Sun Bum company,” and that “[i]t has been almost one year since products were first sold under SKI BUM and there has been no evidence of any confusion.” DiPietro Decl. ¶ 68 (22 TTABVUE 13). Opposer does not dispute that there has been no actual confusion, but argues that the “SKI BUM product has only been for sale for a short period of time and has had only limited sales such that the absence of actual confusion does not play a roll [sic].” 34 TTABVUE 34. We agree with Opposer.

As of the time of Ms. DiPietro’s testimony, the parties’ SUN BUM and SKI BUM marks had been used concurrently for less than a year, DiPietro Decl. ¶ 68 (22 TTABVUE 13), and fewer than 200 units of products under the SKI BUM mark had

been sold, generating revenues of slightly more than \$7,000. 25 TTABVUE 293 (Applicant's Answer to Opposer's Interrogatory No. 9).⁴¹ As noted above, Applicant also argues under the second and third *DuPont* factors that its sales have been made through entirely different channels of trade than those used by Opposer to entirely different customers. "Given the different channels of trade actually used by the parties and the very low level of [Applicant's] sales, there has not been a reasonable opportunity for confusion to have occurred" during the brief period of concurrent use of the parties' marks. *Sabhnani*, 2021 USPQ2d 1241, at *49 (quoting *Citigroup*, 94 USPQ2d at 1660). "We find that the eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion." *Id.*

6. The Variety of Goods on Which the Sun Bum Mark is Used

"The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used." *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *14 (TTAB 2020). "If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant's related good under a similar mark as an extension of the plaintiff's line." *Id.* The '379 Registration covers 16 goods in Class 3, and more than 40 other goods in Classes 16, 18, 20, 21, 24, 25, and 28, a considerable number. 25 TTABVUE 215-24. *Cf. DeVivo*, 2020 USPQ2d 10153, at *15 (claimed common-law use of the opposer's mark on "children's books, T-shirts, tank

⁴¹ In Ms. DiPietro's Declaration, Applicant designated revenue figures for products sold under the SKI BUM mark in 2020 and 2021 as confidential, DiPietro Decl. ¶ 28 (22 TTABVUE 7), but Applicant did not similarly designate the pertinent interrogatory answer as confidential, and Opposer filed them in the publicly accessible TTABVUE files without objection from Applicant.

tops, sweatshirts, hoodies, coffee mugs, stickers, postcards, greeting cards, tote bags and informational and educational services in the STEM fields” were “insufficient to persuade us that Opposer has used her mark on a variety of goods and that this *DuPont* factor favors a finding of likelihood of confusion.”). Given our finding above that the goods are legally identical, however, we find that this factor is neutral in our analysis of the likelihood of confusion.

7. The Extent of Potential Confusion

The twelfth *DuPont* factor considers the “extent of potential confusion, i.e., whether *de minimis* or substantial.” *DuPont*, 177 USPQ at 567. Opposer argues that the extent of potential confusion is substantial because of its widespread distribution of goods bearing the mark shown in the ’379 Registration. 34 TTABVUE 36. Although Applicant’s use of its mark has been quite limited to date, DiPietro Decl. ¶¶ 28-29 (21 TTABVUE 7), we have found above that the marks are similar and the goods, channels of trade, and classes of consumers are identical, so the extent of potential confusion cannot be characterized as *de minimis*. At the same time, the record does support a finding that it is substantial. We find that the twelfth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

8. The Thirteenth *DuPont* Factor

“The thirteenth and final *duPont* factor pertains to ‘any other established fact probative of the effect of use.’” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *15 (TTAB 2019) (quoting *DuPont*, 177 USPQ at 567). “This includes a variety of circumstances,” *id.*, including ones in which plaintiffs claim that defendants adopted their marks in bad faith. *See, e.g., Tao Licensing*, 125 USPQ2d at 1063. Here,

however, it is Applicant, not Opposer, who invokes the thirteenth factor in claiming that Opposer has acted in bad faith because its “use of its SUN BUM marks changed after Opposer became aware of the SKI BUM product and filed the Notice of Opposition, which further supports the position that Opposer is now attempting to unfairly expand its scope of rights.” 36 TTABVUE 38.⁴²

Applicant neither cited any cases in which the thirteenth *DuPont* factor has been used to establish a plaintiff’s bad faith (and we are aware of none), nor asserted any affirmative defense, such as unclean hands, to which its claim of bad faith might pertain. Opposer nevertheless addressed Applicant’s arguments on the merits in Opposer’s reply brief, 39 TTABVUE 14-15, so we will consider the parties’ evidence and argument under the thirteenth *DuPont* factor.⁴³

The gist of Applicant’s argument is that Opposer adopted elements of the trade dress of Applicant’s products after Opposer became aware of them. 36 TTABVUE 38-39. Applicant argues that “[i]t appears the packaging design, which is a clear knockoff of Applicant’s product, is an attempt to create after-the-fact evidence to support its position that there is a likelihood of confusion between the marks,” *id.* at 39, and that Opposer “has likely recognized the value in this mark and is trying to unfairly expand its rights to prevent this small business from achieving success” and “does not own a

⁴² Applicant redacted portions of its brief discussing the thirteenth *DuPont* factor. 36 TTABVUE 38-93. We have discussed them to the extent necessary to explain our analysis of Applicant’s claim.

⁴³ Opposer redacted portions of its reply brief discussing the thirteenth *DuPont* factor. 39 TTABVUE 14-15. We have discussed them to the extent necessary to explain our analysis of Applicant’s claim.

monopoly over BUM-based marks, as evidenced by the vast number of third-party marks, and it should not be allowed to wrongly use this forum to prevent Applicant from achieving registration for its distinct and very different mark.” *Id.*

Opposer responds that the expansion of its product line “had been launched prior to the August 6, 2021 date of the [Smith] declaration,” 39 TTABVUE 14, that “Applicant did not file its application for registration of SKI BUM until February 19, 2020, well after [Opposer] had already begun working on expanding its skin care product line,” *id.* at 15, and that “the first time anyone at [Opposer] ever saw Applicant’s SKI BUM product was not until October 19, 2020, by which time [Opposer] had already selected it’s [sic] the packaging colors for its expanded skin care products.” *Id.* Mr. Smith testified regarding the process of the expansion of Opposer’s skin care line, Smith Decl. ¶ 36 (13 TTABVUE 16; 16 TTABVUE 16), and Applicant cross-examined him at some length on that subject. Smith Tr. 18:16-24; 32:16-40:5 (26 TTABVUE 20, 34-42). Mr. Smith’s testimony in his declaration, including redacted portions, and his testimony on cross-examination, support the chronology of events discussed in Opposer’s reply brief. We find that the thirteenth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

9. Summary of the *DuPont* Factors

The first, second, third, fourth, and fifth *DuPont* factors support a finding of a likelihood of confusion to one degree or another, while the sixth, eighth, ninth, twelfth, and thirteenth *DuPont* factors are neutral. The goods, channels of trade, and classes of consumers are identical, the marks are similar, and Opposer’s composite SUN BUM mark shown in the ’379 Registration is conceptually strong and we have

placed it on the “strong” end of the commercial strength spectrum from very strong to very weak and have found that it is entitled to more than the normal scope of protection. Applicant did not show that the mark shown in the ’379 Registration has been weakened conceptually or commercially by third-party uses and registrations of BUM-formative marks, the absence of evidence of actual confusion is immaterial under the circumstances, and Opposer did not act in bad faith in extending the use of its SUN BUM mark to additional goods.

On the basis of the record as a whole, we find that Opposer proved, by a preponderance of the evidence, that Applicant’s use of its SKI BUM mark for legally identical goods is likely to cause confusion as to the source or sponsorship of those goods.

Decision: The opposition is sustained.